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ALEXANDER L. STEVAS,
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IN THE

Supreme Court of the United States

October Term, 1982

NORRIS INDUSTRIES, INC.,

Petitioner,

v.

INTERNATIONAL TELEPHONE AND TELEGRAPH CORPORATION

and

DAVID L. LADD, REGISTER OF COPYRIGHTS,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

Of Counsel:

R. James Shaffer
NORRIS INDUSTRIES, INC.
One Golden Shore
Long Beach, CA 90802
(213) 453-6676

Joseph R. Papp
Charles H. Blair
John A. Sinclair
HARNESS, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, MI 48011
(313) 642-7000

Counsel for Petitioner

QUESTIONS PRESENTED

I.

WHETHER THE ELIGIBILITY OF MODERNISTIC SCULPTURAL WORKS FOR COPYRIGHT PROTECTION UNDER THE COPYRIGHT LAWS SHOULD BE LIMITED TO THE CATEGORIES OF "FINE OR APPLIED ART" WHICH HAVE BEEN "TRADITIONALLY" CONSIDERED COPYRIGHTABLE, CONTRARY TO THE MANDATE OF THIS COURT IN *MAZER v. STEIN*, 347 U.S. 201 (1954), AND *BLEISTEIN v. DONALDSON LITHOGRAPHING CO.*, 188 U.S. 239 (1903).

II.

WHETHER IT CONSTITUTES A VIOLATION OF PRINCIPLES OF FUNDAMENTAL FAIRNESS AND A DENIAL OF PROCEDURAL DUE PROCESS TO DECIDE THE ELIGIBILITY OF A SCULPTURAL WORK FOR PROTECTION UNDER THE COPYRIGHT LAWS BY RESOLVING QUESTIONS OF USEFULNESS, ORNAMENTATION AND SEPARABILITY (OF ORNAMENTAL FEATURES FROM UTILITARIAN FEATURES) BASED ON DEFERENCE TO A DECISION OF THE COPYRIGHT OFFICE WHERE: (A) SUCH A DECISION IS BASED ON THE IMPROPER APPLICATION OF AN ADMINISTRATIVE REGULATION RATHER THAN ITS INTERPRETATION, (B) THE REGULATION HAS NOT BEEN CONSISTENTLY APPLIED BY THE COPYRIGHT OFFICE, AND (C) THE COPYRIGHT OFFICE HAS ADMITTED THAT IT HAS NO TECHNICAL EXPERTISE IN DRAWING THE CONCLUSIONS NECESSARY TO MAKE THE DECISION.

III.

WHETHER TECHNICAL ISSUES UNDERLYING ELIGIBILITY OF SCULPTURAL WORKS FOR COPYRIGHT PROTECTION UNDER THE COPYRIGHT LAWS CAN PROPERLY BE RESOLVED BY WAY OF SUMMARY JUDGMENT WITHOUT MAKING BASIC SCIENTIFIC FACTUAL DETERMINATIONS RELATING TO COPYRIGHTABILITY, SUCH AS REQUIRED BY THIS COURT IN *GRAHAM v. JOHN DEERE CO.*, 383 U.S. 1 (1966), IN SIMILAR INTELLECTUAL PROPERTY CASES INVOLVING THE PATENTABILITY OF UTILITY INVENTIONS.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
TABLE OF AUTHORITIES	v
OPINIONS BELOW	2
JURISDICTION	2
CONSTITUTIONAL PROVISIONS, STATUTES, AND REGULATIONS INVOLVED	2
STATEMENT OF THE CASE	
1. Subject Matter	3
2. The Copyright Office Proceedings Regarding Norris' Registered Copyright	4
3. The Copyright Office Proceedings Regarding Norris' Unregistered Copyright	5
4. The District Court Proceeding	6
5. Uncontroverted Facts Regarding The Nature Of The Ornamental Trim In Suit	7
6. Applicable Law	9
REASONS FOR GRANTING THE WRIT	
I. The Decision Of The Court Below Improperly And Arbitrarily Discriminates Against A Particular Form Of Artistic Expression In Violation Of The Mandates Of This Court ...	11
II. Rendering Judgment By Deferring To The Copyright Office's Unsupported Conclusions Violates Fundamental Fairness And Constitutes A Denial Of Procedural Due Process	15

	Page
III. Resolution Of The Eligibility Of Norris' Ornamental Trim For Copyright Requires Fundamental Factual Determinations Inappropriate For Summary Judgment	24
CONCLUSION	28
APPENDICES	
Appendix "A" — Opinion Of The United States District Court For The Northern District Of Florida, Norris Industries, Inc. v. International Telephone And Telegraph Corp. and David L. Ladd, Register Of Copyrights, 212 U.S.P.Q. 754 (N.D. Fla. 1981)	A-1
Appendix "B" — Opinion Of The United States Court Of Appeals For The Eleventh Circuit, Norris Industries, Inc. v. International Telephone And Telegraph Corp. and David L. Ladd, Register Of Copyrights, 696 F.2d 918 (11th Cir. 1983)	B-1
Appendix "C" — Order Of The United States Court Of Appeals For The Eleventh Circuit, Norris Industries, Inc. v. International Telephone And Telegraph Corp. and David L. Ladd, Register Of Copyrights, March 18, 1983, denying rehearing en banc	C-1
Appendix "D" — Constitutional Provisions, Statutes And Regulations Involved In This Petition	D-1
Appendix "E" — Photographs Of Record Relating To Norris' Ornamental Trim In Suit	E-1
Appendix "F" — Legislative History Of 17 U.S.C. § 101 Of The 1976 Copyright Act, H.R. Rep. 1476, 94th Cong., 2d Sess. 55 (1976), 1976 U.S. Code Cong. & Admin. News 5659, 5668	F-1

TABLE OF AUTHORITIES

	Page
Cases:	
Amchem Products, Inc. v. GAF Corporation, 594 F.2d 470 (5th Cir. 1979); <i>modified</i> , 602 F.2d 724 (5th Cir. 1979)	23
Ted Arnold Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y. 1966)	5, 14, 20
Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 23 S. Ct. 298, 47 L.Ed. 460 (1903) 13,15,28	
Cadence Industries Corp. v. Ringer, 450 F. Supp. 59 (S.D.N.Y. 1978)	19
Dan Kassoff, Inc. v. Gresco Jewelry Co., 204 F. Supp. 694 (S.D.N.Y. 1962)	20
De Sylva v. Ballentine, 351 U.S. 570, 76 S. Ct. 974, 100 L.Ed. 1415 (1956)	19
Diamond v. Chakrabarty, 447 U.S. 303, 100 S. Ct. 2204, 65 L.Ed.2d 144 (1980)	14
Diamond v. Diehr, 450 U.S. 175, 101 S. Ct. 1048, 67 L.Ed.2d 155 (1981)	14
Donner Hanna Coke Corp. v. Costle, 464 F. Supp. 1295 (W.D.N.Y. 1979)	18
Esquire, Inc. v. Ringer, 414 F. Supp. 939 (D.D.C. 1976); <i>reversed</i> 591 F.2d 796 (D.C. Cir. 1978); <i>cert. denied</i> , 440 U.S. 908, 99 S. Ct. 1217, 59 L.Ed.2d 456 (1979)	18, 20, 24
Graham v. John Deere Co., 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed.2d 545 (1966)	24, 27, 28

	Page
GTE Sylvania, Inc. v. Consumer Product Safety Commission, 443 F. Supp. 1152 (D. Del. 1977); <i>aff'd</i> , 598 F.2d 790 (3rd Cir. 1979); <i>aff'd</i> , 447 U.S. 102, 100 S. Ct. 2051, 64 L.Ed.2d 766 (1980)	18
Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2nd Cir. 1980)	26
Mazer v. Stein, 347 U.S. 201, 74 S. Ct. 460, 98 L.Ed. 630 (1954)	9, 11-15, 28
Midway Mfg. Co. v. Bandai-America, Inc., 546 F. Supp. 125 (D.N.J. 1982)	22
Norris Industries, Inc. v. International Telephone And Telegraph Corp., 212 U.S.P.Q. 754 (N.D.Fla. 1981); <i>aff'd</i> , 696 F.2d 918 (11th Cir. 1983)	1, 8, 11, 21-22
Pacific Coast Medical Enterprises v. Harris, 633 F.2d 123 (9th Cir. 1980)	18, 23
Patagonia Corp. v. Board of Governors of Fed. Res. Sys., 517 F.2d 803 (9th Cir. 1975)	16-18
Russell v. Law Enforcement Assistance Administration, 637 F.2d 1255 (9th Cir. 1980)	18, 23
Skidmore v. Swift & Co., 323 U.S. 134, 140, 65 S. Ct. 161, 89 L.Ed. 124 (1944)	18, 21
Trans-World Mfg. Corp. v. Al Nyman & Sons Inc., 95 F.R.D. 95 (D.Del. 1982)	27
United States v. Missouri Pacific R.R., 278 U.S. 269, 49 S. Ct. 133, 73 L.Ed. 322 (1929)	18, 20

Constitution, Statutes and Regulations:

Article I, Section 8 of the Constitution	2, 15, 28
17 U.S.C. § 5 (1909 Copyright Act)	2, 9
17 U.S.C. § 101 (1976 Copyright Act)	2, 8, 10, 14, 19
17 U.S.C. § 411(a)	6, 18
28 U.S.C. § 1254	2
35 U.S.C. § 103	25
37 C.F.R. § 202.10(c) (1959)	2, 9, 10, 19, 20, 24
Federal Rule of Civil Procedure 56	18, 27

Other:**Compendium Of Copyright Office Practices:**

§ 2.8.1 I.b.1	2, 10, 20, 24
§ 2.8.1 I.b.2	2, 10, 20, 24
§ 2.8.3 I.b.	2, 10
§ 2.8.3 I.d.	2, 10

H.R. Report No. 1476, 94th Cong. 2d Sess. (1976), 1976 U.S. Code Cong. & Adm. News 5659	8, 14, 22
--	-----------

Advisory Committee's Note Regarding Federal Rules Of Evidence 201	16, 17
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**PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT**

—•—
Norris Industries, Inc., respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Eleventh Circuit entered in this proceeding.

OPINIONS BELOW

The opinion of the District Court for the Northern District of Florida (Appendix A, *infra*) is reported at 212 U.S.P.Q. 754.

The opinion of the United States Court of Appeals for the Eleventh Circuit (Appendix B, *infra*) is reported at 696 F.2d 918.

The Order of the Eleventh Circuit Court of Appeals denying rehearing en banc is set forth in Appendix C, *infra*.

JURISDICTION

The original judgment of the Eleventh Circuit was entered on January 28, 1983. The subsequent order of the Eleventh Circuit denying rehearing en banc was entered on March 18, 1983. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254.

CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS INVOLVED

The Constitutional, statutory and regulatory provisions involved in this Petition include:

- Article 1, Section 8 of the Constitution.
- Section 5 of the 1909 Copyright Act, 17 U.S.C. § 5.
- 37 C.F.R. 202.10(c) (1959).
- The Compendium of Copyright Office Practices, §§ 2.8.1 I.b.1, 2.8.1 I.b.2, 2.8.3 I.b and 2.8.3 I.d.
- Section 101 of the 1976 Copyright Act, 17 U.S.C. § 101.

Due to the length of these provisions, they are set forth in Appendix D, *infra*.

STATEMENT OF THE CASE

1. Subject Matter

The subject matter of this Petition¹ is the copyrightability of two unique and original designs for ornamental wheel trim ("Ornamental Trim") which, in a sculptural and aesthetically unique form, simulate the appearance of a real wire wheel when applied as decorative trim to the otherwise plain and ugly wheels of an automobile.² Involved is the validity of a copyright registration ("Registered Copyright") granted by the Copyright Office on the first design, and the eligibility for copyright of the second design ("Unregistered Copyright") which was denied registration by the Copyright Office. This Petition stems from an affirmance by the Eleventh Circuit of a grant of summary judgment declaring the Registered Copyright and the Unregistered Copyright to be invalid as a matter of law.

¹ Petitioner Norris Industries, Inc. is referred to hereinafter as "Norris". The Appellees below, International Telephone And Telegraph Corporation, and David L. Ladd, Register of Copyrights, are referred to hereinafter as "ITT" and the "Copyright Office", respectively.

² The Ornamental Trim each comprise a simulated hub of a wheel, a simulated wheel rim and a series of metal tubes which are formed in the shape of spokes and are connected between the simulated hub and rim. These components are in bright, shiny chrome plate and provide the appearance of a real wire wheel when applied to a stock automobile wheel. See photos in Appendix E, pp. E-1, E-2, *infra*.

In considering the applicable facts³, it should be noted that concepts relating to the eligibility of articles such as Ornamental Trim for copyright hinge on technical factual determinations of:

- (1) Is the Ornamental Trim a "useful article" or is it an "ornamental article"?
- (2) If the Ornamental Trim is a "useful article", are the ornamental features physically or conceptually separable from the utilitarian features?

2. The Copyright Office Proceedings Regarding Norris' Registered Copyright

The file history of Norris' Registered Copyright shows that a series of three applications for registration were submitted to the Copyright Office. In granting the registration on the third application, the Copyright Office found that its prior rejections had been based upon its *misconception* of the role played by the spokes. In this regard, the Office stated in its letter of August 5, 1976 (Vol. 4, pp. 690-691):

"Although the principles set forth in Mr. Dietz's letter of December 17, 1975, are correct and are an accurate statement of our practices, there appears to be a misconception of the role played by the spokes.

"A wire wheel cannot be copyrighted. No matter how the spokes are arranged, they serve a utilitarian purpose. However, it is my understanding that the spokes appearing on this

³ Throughout this Petition, references to the facts of Record will be by way of the following citation: (Vol. —, p. —).

work are purely decorative. They serve no utilitarian purpose whatsoever, but are purely decorative and serve only to simulate the appearance of a wire wheel. See *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966). This work may be distinguished from a wire wheel in that if the spokes were removed from a wire wheel, the wheel would cease to exist but if the spokes were removed from this work, the wheel cover would still retain its function."

Thus, the Copyright Office realized its mistake, noted that the spokes are "purely decorative" and "serve no utilitarian purpose whatsoever", and granted the registration (GP-110, 114).

3. The Copyright Office Proceedings Regarding Norris' Unregistered Copyright

Norris' first application for copyright for the second Ornamental Trim (Vol. 4, pp. 562-570) was refused (Vol. 4, p. 571) upon the ground of a *lack of originality* relative to Norris' previously copyrighted Ornamental Trim (GP-110, 114). A second Norris application (Vol. 4, pp. 572-590) was also rejected for lack of *originality* (Vol. 4, pp. 591-592). The latter rejection was challenged by a third application (Vol. 4, pp. 594-598), accompanied by an affidavit of H. R. Beisch (Vol. 4, pp. 599-625) which, while directed to the originality question, also testified to the non-functionality of the Ornamental Trim. The Copyright Office rejected the third application on lack of *originality*, and on the basis that the Ornamental Trim was a *useful article* (Vol. 4, pp. 631-633).

A fourth Norris application (Vol. 4, pp. 634-641) again challenged the Copyright Office's rejection with specific emphasis placed on the impropriety of the Copyright

Office's characterization of the Ornamental Trim as a "useful article". This application cited the previously submitted Beisch affidavit, which stated:

"These simulated wire wheel covers are strictly decorative and ornamental. They do not in any way support the vehicle or perform any structural or wheel function on the vehicle . . ." (Vol. 4, pp. 634-635).

In response, the Copyright Office *retreated* from its "useful article" rejection and returned to its initial ground for rejection as the basis for its *final* rejection, i.e. lack of *originality* relative to Norris' previously Registered Copyright (Vol. 4, pp. 643-644).

4. The District Court Proceeding

Late in 1980, ITT copied Norris' Ornamental Trim designs. Because of this copying, Norris instituted suit against ITT under 17 U.S.C. § 411(a) for infringement of the Unregistered Copyright. Pursuant to 17 U.S.C. § 411(a), the Copyright Office joined in the suit for the purpose of contesting registerability of the Unregistered Copyright. ITT filed a second suit which asked for, *inter alia*, a declaratory judgment of invalidity of Norris' Unregistered Copyright *and* Registered Copyright. The second suit was consolidated with the first suit.

ITT thereafter filed a motion for summary judgment seeking a declaration of invalidity of both the Registered Copyright and the Unregistered Copyright. ITT argued in its accompanying brief (*without supporting affidavits*) that Norris' Ornamental Trim were not copyrightable on the grounds that: (1) they were "useful articles"; and (2) the ornamental features of the Trim could not be identified separately and exist independently of the utilitarian features of the Trim. The Copyright Office also filed a motion for summary judgment and supporting brief (*without affidavits*) asserting invalidity of Norris' Unregistered Copyright. The Copyright Office's position

closely paralleled that set forth by ITT.⁴ In its brief, the Copyright Office also argued that it had made a *mistake* in granting Norris' Registered Copyright. Norris both factually and legally controverted each and every *unverified* point raised by ITT and the Copyright Office in a detailed brief filed *with supporting affidavits*.⁵

5. Uncontroverted Facts Regarding The Nature Of The Ornamental Trim In Suit

Uncontroverted facts regarding the nature of the Ornamental Trim were submitted by Norris in the affidavit of H. R. Beisch, Senior Vice President of Norris, having fifteen years experience with the engineering and other aspects of ornamental trim for automotive wheels (Vol. 5, pp. 776-777). The first fact is that the Ornamental Trim is *not* a wheel (Vol. 5, pp. 777-779, 782). Thus, while a real wheel is a utilitarian device which supports a vehicle, the Ornamental Trim serves no such function. Indeed, the purpose of Ornamental Trim is to *adorn* a wheel and cover its ugliness (Vol. 5, pp. 777-779, 780). The Ornamental Trim can be readily applied to a wheel and removed therefrom, and the wheel performs the same function with or without the Ornamental Trim. (Vol. 5, pp. 778, 779). One form of the design has a

⁴ Neither ITT nor the Copyright Office asserted in this proceeding the invalidity of the Unregistered Copyright by reason of lack of originality, because they both conceded that such a claim involves material questions of fact improper for summary judgment.

⁵ In support of their motions, both ITT and the Copyright Office relied upon the following: (1) File history of Norris' Registered Copyright GP-110, 114 (Vol. 4, pp. 645-693); (2) File history of Norris' Unregistered Copyright (Vol. 4, pp. 556-644); (3) Unverified statements of fact in ITT's brief (Vol. 3, pp. 543-554); (4) Unverified statements of fact in the Copyright Office's brief (Vol. 5, pp. 813-834).

In opposition to the motions, Norris, in addition to the two file histories noted above, relied upon the following: (1) Affidavit of Hans R. Beisch, Senior Vice President of Norris (Vol. 5, pp. 776-795); (2) Affidavit of Heinrich J. Hempelmann, Manager, Product Development of Norris (Vol. 5, pp. 796-800); (3) Affidavit of Timothy Edwards, Sales Engineer of Norris (Vol. 5, pp. 801-804); (4) Affidavit of James C. Coughenour, Clerk for Harness, Dickey & Pierce (Vol. 5, pp. 805-809); (5) The pleadings in the consolidated cases.

None of the parties submitted testimony, either by deposition or at the hearing on the motions.

backing plate located behind the simulated hub, rim and spokes, and another form of the design has *no* backing plate and is thus open to the wheel (Appendix E, p. E-3).

Copyright is available to the ornamental features of an article which are either *physically* or *conceptually* "separable" from the utilitarian features of the article.⁶ In the present case, any utilitarian function, such as *alleged* by the unverified statements of ITT and the Copyright Office, would not be performed by the artificial spoke pattern of Norris' Ornamental Trim, but, if at all, by the backing plate, and then in only one of the designs of the Trim.⁷ Yet, the only *evidence* of record establishes the existence of questions of material technical fact as to the issue of "separability". In this regard, the following *uncontroverted* facts establish physical and/or conceptual "separability":

1. The fact that the backing plate of Norris' Trim could be (and has been) removed leaving the simulated rim, spokes and hub intact (Vol. 5, pp. 781-782, 795). The photograph of record (Vol. 5, p. 795) evidencing this fact is reproduced in Appendix E, p. E-3.
2. The fact that the simulated hub and spokes could be removed leaving the backing plate

⁶ See legislative history of 17 U.S.C. § 101 of the 1976 Copyright Act, H.R. Rep. No. 1476, 94th Cong. 2d Sess. 55 (1976), 1976 U.S. Code Cong. and Admin. News 5659, 5668 set forth in Appendix F, *infra*, and referred to hereafter as "House Report".

⁷ ITT and the Copyright Office alleged that the Trim protects brakes, axles, bearings, lug nuts, etc. *See*: 696 F.2d at 922; Appendix B, p. B-7. The unverified allegations of utility by ITT and the Copyright Office were, however, controverted in detail by a verified scientific analysis in the Beisch affidavit (Vol. 5, pp. 776-795) showing that openings in the wheel and backing plate freely admitted water, dirt, debris, etc.

(Vol. 5, pp. 781, 794). Photographs of record (Vol. 5, p. 794) evidencing this fact are also reproduced in Appendix E, p. E-4.

3. The fact that the Ornamental Trim are frequently used to adorn other parts of the vehicle (Vol. 5, pp. 801-804). The photograph of record (Vol. 5, p. 804) evidencing this fact is also reproduced in Appendix E, p. E-5.
4. The finding of "separability" by the Copyright Office with regard to Norris' Registered Copyright (Vol. 4, pp. 690-691).

6. Applicable Law

In *Mazer v. Stein*, 347 U.S. 201 (1954), this Court provided guidance and clarified the standards governing copyrightability of three dimensional works of art under Section 5(g) of the 1909 Copyright Act. In the wake of this Court's pronouncement in *Mazer v. Stein*, the Copyright Office adopted the following regulation, which governed the copyrightability of three dimensional articles and sculptural works:

"If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration." 37 C.F.R. § 202.10(c) (1959).

Thus, 37 C.F.R. § 202.10(c) indicates that the question of whether a sculptural article is eligible for copyright protection requires a technical factual determination of

whether or not it has utility, and if so, whether it possesses ornamental features which are physically or conceptually separable from utilitarian features.⁸

In addition to the above, the Copyright Office adopted a "Compendium of Copyright Office Practices" which amplifies the above rules. Thus, the Compendium sets forth definitions of "Ornamental Articles" and "Useful Articles" and the copyrightability of same. According to the Compendium (Appendix D, *infra*), a sculptural article is entitled to copyright if:

- (1) it is sufficiently "Original" (Section 2.8.3 I.b.), *and*
- (2) (a) it is an "Ornamental Article" designed primarily to beautify, embellish or adorn (Section 2.8.1 I.b.1.), *or*
 (b) it is a "Useful Article" designed primarily to serve a utilitarian function (Section 2.8.1 I.b.2.), and the sculptural features thereof can be identified separately and exist independently of the utilitarian features. (Section 2.8.3 I.d.)

⁸ These standards are now set forth in 17 U.S.C. § 101 of the 1976 Copyright Act, which is a codification of the Copyright Office regulation of 37 C.F.R. § 202.10(c). See Appendix D and Appendix F, *infra*.

REASONS FOR GRANTING THE WRIT

I.

THE DECISION OF THE COURT BELOW IMPROPERLY AND ARBITRARILY DISCRIMINATES AGAINST A PARTICULAR FORM OF ARTISTIC EXPRESSION IN VIOLATION OF THE MANDATES OF THIS COURT

The appellate court's decision distinguishes between *traditional* fine and applied art as being eligible for copyright, and the chrome plated sculpture of artificial spokes and the like of Norris' Ornamental Trim as being ineligible. The Eleventh Circuit's decision would permit copyright protection to elements of *useful articles* "such as a carving on the back of a chair and a floral relief design on silver flatware", and in the same breath would deny copyright protection to the spoke "sculpture" of Norris' Ornamental Trim. See: 696 F.2d at 923-924; Appendix B, pp. B-11 — B-13. This illusory distinction was rationalized by the court as follows:

"Wire wheel covers do not fall within any of the categories of fine or applied art which have been *traditionally* considered copyrightable". 696 F.2d at 924; Appendix B, p. B-13 (emphasis added).

No suggestion of a distinction between copyrightability of designs on articles such as chairs and flatware and wheel trim can be found in this Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954), and indeed such a holding violates the fundamental principles of copyright law set forth in that decision. In *Mazer*, this Court traced the history of previous legislative acts before delineating the scope of eligibility for copyright, and cogently instructed:

"Significant for our purposes was the deletion of the fine-arts clause of the 1870 Act. Verbal

distinctions between purely aesthetic articles and useful works of art *ended* insofar as the statutory copyright language is concerned.

* * *

"This Court once essayed to fix the limits of the fine arts. That effort need not be appraised in relation to this copyright issue. It is clear Congress intended the scope of the copyright statute to include more than the *traditional* fine arts.

* * *

"Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art Such expression, whether meticulously delineating the model or mental image or conveying the meaning by *modernistic form* or color, is copyrightable.

* * *

"We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law." 347 U.S. at 211, 213-214, 218 (emphasis added).

The clear mandate of this Court in *Mazer* is that copyright protection should not be limited to "the traditional fine arts", and that there should be no distinction as to eligibility whereby "a narrow or rigid concept of art" should deny copyright to "expression . . . by modernistic form" *Id.* The Eleventh Circuit clearly erred in imposing such a distinction for eligibility for copyright, contrary to the rule set down by this Court

in *Mazer*. *Mazer* does not support a distinction in copyrightability between carvings on chairs, patterns on flatware and modernistic sculptured designs on Ornamental Trim.

The *Mazer* decision enunciated for sculpture the same caution against discrimination that this Court earlier mandated with regard to painting and engraving in 1903. In *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), Justice Holmes sternly warned against the imposition of narrow personal views on works of art:

"Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright *unless there is a restriction in the words of the act.*

* * *

"It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value, — it would be bold to say that they have not an aesthetic and educational value, — and the taste of any public is not to be treated with contempt." 188 U.S. at 250, 251-252 (emphasis added).

In the present case, the articles in question are shiny, metallic objects used to adorn the plain and ugly wheels of an automobile. No doubt, to some they may represent a garish and transitory form of art. Yet to the eyes of others, they have no less aesthetic beauty than the design on flatware or the carving on a chair back.⁹

The Eleventh Circuit, in denying eligibility for copyright, has obviously discriminated and has imposed an additional limitation upon the copyrightability of sculptural works which does not even exist in the statutory framework set up by Congress.¹⁰ In a related field of intellectual property, this Court has twice recently cautioned that "courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 100 S. Ct. 2204, 65 L.Ed.2d 144 (1980); *Diamond v. Diehr*, 450 U.S. 175, 182, 101 S. Ct. 1048, 67 L.Ed.2d 155 (1981). In the present case, the Eleventh

⁹ Indeed, they constitute an *optional* beautifying automobile trim item for which people have paid more than \$100 per car set. The market for these items greatly exceeds \$60 million per year. The payment of such a premium is a significant indication of the aesthetic value of Norris' Trim, and an important factor supporting their copyrightability. *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733, 736 (S.D.N.Y. 1966).

¹⁰ In discussing the definition of "pictorial, graphic and sculptural works" under 17 U.S.C. § 101 of the 1976 Copyright Act, the House Report states:

"[T]he definition of 'pictorial, graphic and sculptural works' carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality . . .

"In accordance with the Supreme Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954), works of 'applied art' encompass all original pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, regardless of factors such as mass production, commercial exploitation, and the potential availability of design patent protection." House Report at 54; 1976 U.S. Code Cong. and Adm. News 5659, 5668 (emphasis added).

Circuit has, however, read such a limitation into the Copyright Law in clear violation of Article I, Section 8 of the Constitution (Appendix D, *infra*), which gives Congress the sole power over granting intellectual property protection "to promote the progress of science and useful arts." Such judicial action, which rules out copyright protection for sculptural works not satisfying a "traditional" art form criterion, creates a *new* non-statutory test for copyrightability that can only create substantial adverse consequences in the future, and disqualify many novel, unique and commercially significant art forms from copyright protection. The decision of the Eleventh Circuit, which creates this limitation, is a fundamental error which violates Article I, Section 8 of the Constitution and the mandates of this Court in *Mazer* and *Bleistein*, *supra*, and which only this Court can correct.

II.

RENDERING JUDGMENT BY DEFERRING TO THE COPYRIGHT OFFICE'S UNSUPPORTED CONCLUSIONS VIOLATES FUNDAMENTAL FAIRNESS AND CONSTITUTES A DENIAL OF PROCEDURAL DUE PROCESS

The record before the District Court unquestionably showed the existence of genuine issues of material fact as to the threshold copyright questions of "ornamental article", "useful article" and "separability" of ornamental and utilitarian features. Yet in what appears to be an abdication of its judicial function, the District Court totally deferred to the Copyright Office's unsupported conclusions of technical fact that Norris' Ornamental Trim are "useful articles" and possess no separable ornamental features. Moreover, this total deference was given to a determination requiring

technical expertise, despite the lack of any showing of the existence of such expertise in the Copyright Office. In affirming the District Court, the Eleventh Circuit found no fault with the District Court deferring to the Copyright Office's unsupported conclusions. Norris submits that this approach violates basic principles of administrative law.

In the context of administrative law, "legislative facts" are those that affect an industry as a whole. In contrast, "adjudicative facts" are those that immediately affect only specific litigants. *Patagonia Corp. v. Board of Governors of Fed. Res. Sys.*, 517 F.2d 803, 816 (9th Cir. 1975)¹¹ Obviously, the factual issues before the District Court in this case involve disputed *adjudicative facts*, and the mere *existence* of a dispute over these facts clearly required their resolution by way of trial. In this regard, the observations of the Ninth Circuit in *Patagonia*, *supra*, are highly instructive:

"Questions of adjudicative fact must be *resolved* on the basis of the evidentiary submissions of the parties. They are the types of questions that in a trial would normally be submitted to a jury, or to a judge as the finder of facts . . .

* * *

" . . . *Disputed* questions of adjudicative fact normally are not decided without affording to the party that may be adversely affected an evidentiary hearing in which that party has the opportunity to confront witnesses and to hear and contest the evidence against him." 517 F.2d at 816 (emphasis added).

¹¹ See also the Advisory Committee's Note regarding Federal Rule of Evidence 201(a) and (b), contained in 1 Weinstein's Evidence, pp. 201-4 through 201-9.

See also: Advisory Committee's Note regarding F.R.E. 201(b), contained in 1 Weinstein's Evidence, pp. 201-7-8.¹²

These principles should have governed the present case. Norris submitted affidavits both in its applications to the Copyright Office and in the District Court which contain *unrebutted* evidence that Norris' Ornamental Trim are not "useful articles", and that they possess aesthetic features that can be identified separately from, and are capable of existing independently of, any of their supposed utilitarian aspects. These submissions unequivocally demonstrate that the *adjudicative facts* relating to the issues of "ornamental article", "useful article" and "separability" in this case are *in dispute* and can only be resolved in a full evidentiary trial affording Norris with the opportunity to confront witnesses, and

¹² In *Patagonia*, the Ninth Circuit was confronted with the question of what standards should govern a determination by the Federal Reserve Board as to whether Patagonia exercised a controlling influence over another business entity at a given date. Patagonia contended that it was entitled to a full evidentiary hearing as to this issue, with an opportunity to present oral evidence and cross-examine any witnesses against it. The Board, on the other hand, contended that it had fulfilled all procedural requirements for the determination by: (1) simply studying facts, affidavits and memoranda submitted by Patagonia to support its application, and (2) notifying Patagonia by letter of its decision. The Ninth Circuit noted that the issue before the Board involved *adjudicative facts* relating to whether a particular business relationship existed between two entities on a certain date. The court also observed that significant *factual disputes* existed between the Board and Patagonia as to this issue, so as to require a full hearing. In this regard, the court remarked:

"We cannot hold, as Patagonia has requested, that the documentary evidence it submitted to the Board established, as a matter of law, that the asserted power to exercise a controlling influence of Pima existed. But Patagonia's documentation did raise genuine *factual disputes* that must be resolved in a trial-type adversary hearing before the Board." 517 F.2d at 816-817 (emphasis added).

to hear and contest the "evidence" against it — i.e., the unsupported and unverified arguments of ITT and the Copyright Office. Under the structure of the Copyright Office, there was no procedure whereby such a hearing could be had within the agency. Indeed, the only opportunity for such a hearing was in the District Court under 17 U.S.C. § 411(a). By resolving the above-noted questions of adjudicative fact against Norris, the court destroyed any chance for such a hearing, and thus violated the principles of administrative law set forth in *Patagonia, supra*, as well as the principles governing summary judgment under F.R.C.P. 56.

Additionally, the present state of the record afforded no basis for the lower courts to disregard these disputed facts and to *defer* to the Copyright Office's unsupported conclusions. To decide whether deference should be given to particular decisions of an administrative agency such as the Copyright Office, the following factors should apply¹³:

¹³ See: *Skidmore v. Swift & Co.*, 323 U.S. 134, 140, 65 S. Ct. 161, 89 L.Ed. 124 (1944); *United States v. Missouri Pacific R.R.*, 278 U.S. 269, 280-282, 49 S. Ct. 133, 73 L.Ed. 322 (1929); *Russell v. Law Enforcement Assistance Administration*, 637 F.2d 1255, 1264 (9th Cir. 1980); *Pacific Coast Medical Enterprises v. Harris*, 633 F.2d 123, 130-133 (9th Cir. 1980); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979); *Donner Hanna Coke Corp. v. Costle*, 464 F. Supp. 1295, 1303-1304 (W.D.N.Y. 1979); *GTE Sylvania, Inc. v. Consumer Product Safety Commission*, 443 F. Supp. 1152, 1155 (D. Del. 1977), *aff'd*, 598 F.2d 790 (3rd Cir. 1979), *aff'd*, 447 U.S. 102 (1980).

- (1) Does the administrative decision relate to the *interpretation* of an administrative regulation?
- (2) Is the interpretation longstanding and has it been *consistently* applied?
- (3) Does the administrative interpretation relate to a matter within the field of *expertise* of the administrative agency?

None of these tests are satisfied in this case. For example, a determination of utility and/or separability based upon technical data involving adjudicative facts relating to Norris' Ornamental Trim does not involve the *interpretation* of 37 C.F.R. § 202.10(c) or its corollary under 17 U.S.C. § 101 of the 1976 Copyright Act, but rather its *application* to the facts of a particular case.

Moreover, *consistency* of administrative action is sorely lacking in this case. The uncontroverted facts of record show that the Copyright Office *granted* registration for Norris' first design (Registered Copyright) on the basis of "separability" after admitting that its prior rejections were based on a "misconception" of the sculptural spoke design (Vol. 4, p. 690). With the Unregistered Copyright, the Copyright Office *vacillated* in its grounds for rejection from "originality" to "useful article", and grounded its final rejection on lack of "originality". Yet the "deference" accorded by the lower courts relates to inconsistent, unverified statements of utility and lack of separability (and not originality). Thus, the record in this case demonstrates the impropriety of according deference based upon *consistent* administrative action. See: *De Sylva v. Ballentine*, 351 U.S. 570, 577-578, 76 S. Ct. 974, 100 L.Ed. 1415 (1956), and *Cadence Industries Corp. v. Ringer*, 450 F. Supp. 59, 64-66 (S.D.N.Y. 1978), where deference was denied to indecisive Copyright

Office action. In any event, a lack of consistency of the Copyright Office's interpretation of the law regarding "useful articles" is demonstrated by its enunciation of a myriad of conflicting tests for determining whether an article is a "useful article" or an "ornamental article", which include, but are not limited to:

1. Solely utilitarian (37 C.F.R. 202.10(c));
2. Primarily ornamental (Compendium § 2.8.1);
3. Primarily utilitarian (Compendium § 2.8.1);
4. Fundamental reason for being;¹⁴
5. Dual intrinsic function.¹⁵

Such inconsistency should not form the basis for according deference to the Office's views concerning "useful articles". *United States v. Missouri Pacific R.R.*, 278 U.S. 269, 280-282, 49 S. Ct. 133, 73 L.Ed. 322 (1929).

Turning to the question of "separability", expediency rather than consistency would seem to describe the Copyright Office's actions in this case. Thus, in granting the Registered Copyright, the Office found separability to exist because "if the spokes were removed from a wire

¹⁴ See Note 19, *infra*.

¹⁵ In its brief to the District Court in *Esquire, Inc. v. Ringer*, 414 F. Supp. 939 (D.D.C. 1976), reversed, 591 F.2d 796 (D.C. Cir. 1978), the Copyright Office had the problem of explaining the rationale for registration of a pencil sharpener having a telephone casing in *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966), an ornamental cover for a ring box in *Dan Kassoff, Inc. v. Gresco Jewelry Co.*, 204 F. Supp. 694 (S.D.N.Y. 1962), and candlesticks. All were admittedly useful articles. The Copyright Office suggested the propriety of registration on the basis of "dual intrinsic functions". In other words, these articles were both "primarily ornamental" and "primarily utilitarian". It would appear assuming arguendo that Norris' Ornamental Trim performs a "useful function", that the so-called "dual intrinsic function" test would support copyrightability.

wheel . . . the wheel would cease to exist but if the spokes were removed from this work, the wheel cover would still retain its function" (Vol. 4, pp. 690-691). Yet, in the proceedings in the lower courts, the Copyright Office *argued to the contrary* that Norris' Ornamental Trim failed the "separability" test because the sculptural pattern would cease to exist if the spokes are removed from the Trim.¹⁶ The Office asserted in the lower court proceedings that it made a mistake in granting the Registered Copyright. Notwithstanding whether or not a mistake was made, the Copyright Office's conflicting tests of separability in this case speak eloquently of *inconsistency*. Indeed, the record commands such a conclusion. The weight accorded to an agency's judgment in a particular case must depend upon the thoroughness evident in its consideration, the validity of its reasoning, and its consistency with earlier and later pronouncements. *Skidmore v. Swift & Co.*, 323 U.S. 134, 140, 65 S. Ct. 161, 89 L.Ed. 124 (1944). The record in this case shows little, if any, thoroughness and consistency in the Office's pronouncements! Little, if any, weight should therefore be accorded to them. Obviously, a foundation for *deference* based upon consistent administrative action was lacking in this case.

It is also submitted that the determination of whether an article such as Norris' Ornamental Trim is an "ornamental article" or a "useful article" and/or whether the ornamental features are capable of physical or conceptual separability from the utilitarian elements *requires "technical expertise"*. However, the only evidence of record in this case shows a lack of any "technical expertise" in the Copyright Office. Indeed,

¹⁶ It was on this basis that the Eleventh Circuit held that the Trim failed the separability test. See: 696 F.2d at 923; Appendix B, p. B-10. Yet, and incredibly, this latter test of separability is exactly opposite to that utilized by the Office in granting the Registered Copyright.

the Copyright Office neither in its briefs nor in oral argument in the lower courts asserted that it had or denied that it lacks such expertise.¹⁷ Yet the Eleventh Circuit ruled that such technical expertise was not necessary for it to accord deference to the Copyright Office. Thus, the court remarked:

"The expertise relied on is not technical expertise in the use of the article submitted for registration but expertise in the interpretation of the law and its application to the facts presented by the copyright application." 696 F.2d at 922; Appendix B, p. B-8.

Norris submits that the logic of the appellate court is circular and completely misses the point. *Application of the Copyright Law to Norris' Ornamental Trim* requires an *understanding* of whether or not it performs a useful function, and if so, whether aesthetic features can be separated from useful features. This *requires* a technical scientific analysis of the Trim to determine if, in fact, it protects brakes, axles, bearings, lug nuts, etc., such as alleged by the Copyright Office and found by the District Court. See: 696 F.2d at 922; Appendix B, p. B-7. The Copyright Office argued in the trial court that the Trim performed these functions, and yet has admitted that it had *no* technical expertise to assist it in drawing these conclusions.

¹⁷ Unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued. H.R. Rep. No. 94-1476, 94th Cong. 2d Sess., 157, quoted in *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 143-144 (D.N.J. 1982). While dealing with an issue of "originality", the *Midway* court, in a relevant passage, noted: "It is undisputed that the Copyright Office has neither the facilities nor the authority to rule upon the factual basis of applications for registration . . ."

Fundamental principles of administrative law clearly require that an administrative agency's determination must be based upon a matter within its *expertise* before a court can consider giving the determination any deference.¹⁸ Norris submits that the denial of an evidentiary hearing to present to the trier of fact the technical aspects of the design of Norris' Ornamental Trim and the lack of "technical expertise" of the Copyright Office was fundamental error. For the courts in this case to defer to the Copyright Office's bold and unsupported conclusions without allowing Norris an opportunity to prove that they are manifestly wrong is to sanction arbitrary and capricious decision making. The denial of an evidentiary hearing in the face of the uncontroverted facts submitted by Norris was improper, and is indeed a denial of procedural due process which sets a dangerous precedent. This result cries for correction by this Court, not only for the benefit of Norris, but for the benefit of all other future copyright applicants who may otherwise be denied the valuable right to protect their artistic creations under the Copyright Laws by reason of improper and fundamentally unfair summary procedure.

¹⁸ *Russell v. Law Enforcement Assistance Administration*, 637 F.2d 1255, 1264 (9th Cir. 1980); *Pacific Coast Medical Enterprises v. Harris*, 633 F.2d 123, 130-133 (5th Cir. 1980); *Amchem Products, Inc. v. GAF Corporation*, 594 F.2d 470, 476 (5th Cir. 1979), modified, 602 F.2d 724 (5th Cir. 1979).

III.

RESOLUTION OF THE ELIGIBILITY OF NORRIS' ORNAMENTAL TRIM FOR COPYRIGHT REQUIRES FUNDAMENTAL FACTUAL DETERMINATIONS INAPPROPRIATE FOR SUMMARY JUDGMENT

Both the Copyright Office and ITT have claimed in this case that Summary Judgment of invalidity of Norris' Unregistered and Registered Copyrights was proper because the issues of "useful article" and "separability" are questions of law. Norris does not quarrel with the proposition that the question of copyright validity may *ultimately* be one of law. However, the copyright questions relating to Norris' Ornamental Trim — i.e., "ornamental article", "useful article", and, if a "useful article", "separability" of ornamental and utilitarian features, all require underlying *factual* technical determinations.¹⁹ A direct analogy can be found in the Patent Law. In *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct 684, 15 L.Ed.2d 545 (1966), this Court, in

¹⁹ Significantly, the Compendium definitions of "ornamental articles" and "useful articles" have been represented by the Copyright Office to require a *factual* determination of "the fundamental reason for being" of the article. See Copyright Office briefs in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908, 99 S. Ct. 1217, 59 L.Ed.2d 456 (1979). Thus, the Compendium defines "Ornamental Articles" as those designed "primarily to beautify, embellish or adorn" (§ 2.8.1 I.b.1.). In contrast, the Compendium defines "Useful Articles" as those "designed primarily to serve a utilitarian function". (§ 2.8.1 I.b.2.). Each of these definitions obviously mandates a *factual* determination of "the fundamental reason for being" of the article in question. Further, if an article is determined to be a "Useful Article", it is subject to a further *factual* determination as to physical or conceptual separability of ornamental from utilitarian features, which if present permits copyrightability. See: 37 C.F.R. 202.10(c), Appendix D, *infra*.

addressing the question of obviousness of utility inventions under 35 U.S.C. § 103 of the Patent Laws, set forth fundamental guidelines which have governed the courts and United States Patent Office for the last seventeen years. Thus, this Court stated in *Graham*:

"While the ultimate question of patent validity is one of law, . . . , the [Section] 103 condition, . . . lends itself to *several basic factual inquiries*. Under [Section] 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." 383 U.S. at 17 (emphasis added).

Indeed, this Court warned that these factual inquiries should be resolved only on a case-by-case basis. *Id.* at 18. The present question of the copyrightability of Norris' Ornamental Trim requires similar underlying fundamental and *basic factual inquiries* relating to the issues of "ornamental article", "useful article", and "separability". This question is one of first impression of this Court.

In the first place, the question of whether Norris' Ornamental Trim are "ornamental articles" or "useful articles" requires a technical analysis of the facts as to what utilitarian functions (if any) are performed by Norris' Trim, and secondly, as to which parts perform such functions. Moreover, the record in this case shows that these factual inquiries relating to utility are *not* susceptible of a simple analysis. This is demonstrated by

the Copyright Office's admitted *mistake* in the file history of the Registered Copyright in analyzing Norris' Ornamental Trim. Thus, in finally allowing registration, the Office admitted that its prior rejections had all been based upon a *misconception* of the role played by the spokes:

"Although the principles set forth in Mr. Dietz's letter of December 17, 1975, are correct and are an accurate statement of our practices, there appears to be a *misconception* of the role played by the spokes." (Vol. 4, p. 690) (emphasis added).

Additionally, one cannot even address the question of "separability" until a technical factual analysis of the functional elements of Norris' Trim is resolved.

Moreover, the Second Circuit, in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2nd Cir. 1980), recognized and warned that "separability" is also a *factual* question which can be resolved only on a *case-by-case* basis. Significantly, in finding *utilitarian* belt buckles to contain copyrightable subject matter, the Second Circuit specifically relied upon *evidence* of "conceptual separability":

"We see in appellant's belt buckles conceptually separable sculptural elements, *as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist*. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function." 632 F.2d at 993 (emphasis added).²⁰

²⁰ In the present case, similar *evidence* of conceptual separability exists because Norris' Ornamental Trim is used to adorn vehicle trunk lids, where it obviously performs *no* utilitarian function. See photo in Appendix E, p. E-5, *infra*.

More recently, in *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D.Del. 1982), the court denied *summary judgment* for non-copyrightability of an admitted useful article (an eyeglass display which had been refused registration by the Copyright Office) because of a question of fact regarding lack of separability of ornamental features from utilitarian features. In this regard, the court observed:

"Such a conclusion should be made by the trier of fact on the basis of *expert testimony* rather than as a matter of law by this Court on the scant record before it." 95 F.R.D. at 99 (emphasis added).

The *only* facts of record in this case were the *uncontroverted* facts submitted in affidavits by Norris showing why the *unverified* statements of IIT and the Copyright Office as to utility and lack of separability were without merit. Yet summary judgment was granted by the District Court and affirmed by the Eleventh Circuit. This is clearly in violation of the mandate of F.R.C.P. 56, and the principles of *Graham v. John Deere, supra*, which mandates that the rights to intellectual property can be resolved only on a *case-by-case* basis.

CONCLUSION

For the reasons set forth above, it is submitted that the Eleventh Circuit's decision in this case discriminates against certain art forms contrary to Article I, § 8 of the Constitution and this Court's mandates in *Mazer v. Stein*, 347 U.S. 201 (1954), and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). The decisions of the lower courts further denied Norris a valuable property right without procedural due process. Finally, the procedures applied by the Copyright Office and the lower courts in this case precluded a factual inquiry into the basic technical issues underlying the copyrightability of sculptural works, contrary to the spirit of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The grant of this Petition For A Writ Of Certiorari is therefore most respectfully urged.

Respectfully submitted,

Joseph R. Papp
Charles H. Blair
John A. Sinclair
HARNESS, DICKY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 642-7000

Attorneys for Petitioner
Norris Industries, Inc.

Of Counsel:

R. James Shaffer
NORRIS INDUSTRIES, INC.
One Golden Shore
Long Beach, California 90802
(213) 435-6676

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APPENDICES

APPENDIX A

ORDER

(United States District Court
Northern District of Florida
Tallahassee Division)

(Filed August 12, 1981)

(Norris Industries, Inc, Plaintiff, v International Telephone and Telegraph Corporation, and David L. Ladd, Register of Copyrights, Defendants — TCA 80-1027; International Telephone and Telegraph Corporation, Plaintiff, v Norris Industries, Inc, Defendant — TCA 81-0774)

Before the court are International Telephone and Telegraph Corporation's (ITT's) motions for partial summary adjudication (Document 42 in TCA 80-1027, Document 33 in TCA 81-0744) and Defendant Ladd's motion for summary judgment (Document 49 in TCA 80-1027). Oral argument on these motions was heard by the court on June 4, 1981, at which hearing the court announced its intention to grant both motions on the basis that Norris Industries, Inc.'s registered (GP 110, 114)) and unregistered copyrights at issue herein are invalid as a matter of law.

In 1975 Norris submitted two separate applications for copyright registration of its "ornamental trim for automotive wheel" (wire wheel covers) both of which were initially refused on the grounds ITT now urges on this court. These denials were followed by a third application which argued that a copyright should be registered in view of the district court decision in

Esquire, Inc. v. Ringer, 414 F. Supp. 939 (D.D.C. 1976), reversed 591 F. 2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). The Copyright Office acquiesced on the basis that doubtful cases are resolved in favor of registerability. Although *Esquire* was reversed on appeal, the Norris copyright has not been invalidated or retracted because no mechanism exists for such invalidation.

In 1977 and 1978 Norris's subsequent applications for registration of ornamental trim for automotive wheels of a different design were refused on the ground that the wire wheel covers lacked sufficient sculptural expression to be considered works of art. The Copyright Office further based its refusal to register on the basis that the wire wheel covers were uncopyrightable "useful articles" under the Copyright Act of 1976, 17 USC § 101 (1976).

Because a determination of registerability under 17 USC § 411(a) replaces a mandamus action against the Register under the 1909 Act, the same standards should apply. Therefore, a denial of registration by the Register may not be overturned by this court absent the showing of an abuse of discretion, *See Esquire, supra*, at 806 n.28. Norris has not made such a showing here.

The utilitarian aspects of a work have never been subject to copyright protection. *See Mazer v. Stein*, 347 U.S. 201 at 212 n.23. After the decision in *Mazer v. Stein*, the limiting regulations were revised to include the following:

If the intrinsic function of an article is its utility, the fact that the article is unique and is attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing

independently as a work of art, such features will be eligible for registration.

Esquire, Inc. v. Ringer, 591 F. 2d 796, 800 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), quoting 37 CFR § 202.10(c) (repealed).

The Register's interpretation of § 202.10(c), which caused him to reject Norris's initial applications for copyright of ornamental wheel trim just as it had caused him to reject copyright of the lighting fixtures in the *Esquire* case, derived from the principle that industrial designs are not eligible for copyright. "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." *Esquire*, *supra* at 800.

Under the Copyright Act of 1976, which codified the pre-existing law regarding the non-copyrightability of useful articles, only features which are capable of independent existence are eligible for copyright protection. 17 USC § 101 provides:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspect of the article.

A "useful article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

The bill which contained the 1976 Copyright Act had originally contained a proposed Title II which would have provided for copyright in industrial designs. Title II was deleted from the final bill. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976). *See also, Esquire, supra* at 801 n.13. There was strong objection to creation of a new form of intellectual property and concern over the anti-competitive effects inherent in granting a 75 to 100 year monopoly over the designs of consumer goods. Cong. Rec. H10873-74 (September 22, 1976). *Esquire, supra* at 801. Basically, the 1976 Act is a recodification of the pre-existing law with regard to the scope of protection of utilitarian articles. *Esquire, supra*, at 803.

Norris argues that their wire wheel covers serve no useful purpose other than to ornament or beautify an automobile, yet the Register's categorization of simulated wire wheel covers as "useful articles" as defined in the 1976 Act appears to be logical and proper. The Register and ITT argue that this particular "ornamental trim for automobile" has an "intrinsic utilitarian function," *i.e.*, it covers the end of the axle of a car and provides some degree of protection to lug nuts, brakes, the wheel, and the axle. Furthermore, a wheel cover is designed to be a part, however aesthetically pleasing, of an automobile, which is itself a "useful article." The court takes judicial notice of the history of the automobile hubcap. The court also notes the Register's experience with the concepts of "intrinsic function," "works of art," and separation of features and

defers to the Register's determination that the simulated wire wheel cover is a useful article. See *Esquire*, *supra* at 801, n.18.

Norris sought to claim copyright in its wheel covers as a whole. In essence, Norris seeks to claim copyright in the overall shape of a useful article, the same objective as that of the claimant in *Esquire*, asserting the exact proposition which the Register and the appellate court rejected in that case. The prior Norris wheel cover registration, granted in the wake of a court decision which was later soundly reversed, does not indicate any misapplication of the copyright statute and its regulations in the subsequent denials of registration.

Although an element may be eligible for copyright protection if it is either "physically or conceptually" separable, the overall design or configuration of a utilitarian object, "even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." *Esquire*, *supra* at 803-4.

In accordance with 17 USC § 101, only those aspects which can be separately identified and which are capable of existing independently can be copyrighted. See H.R. Rep. No. 1476, 94th Cong. 2d Sess. 50 (1976), U.S. Code Cong. Admin. News 1976, p. 5668. The issue of registration of Norris's simulated wire wheel covers is distinguishable from the issue of registration in *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) in which a copyright in a simulated antique telephone was registered despite the telephone's use as a casing for a pencil sharpener. As in *Mazer v. Stein*, *supra*, the incorporation of the entirely separable work of art into a housing for a useful article did not render the work of art uncopyrightable.

The pattern formed by the spokes in Norris's wheel cover is not conceptually or physically separable because the spokes connect the rim and hub portions of the trim and the pattern does not exist if the spokes are removed. The simulation of a wire wheel, which Norris seeks to copyright, is not created solely by the spokes anyway, but by the entire wheel cover. Thus, there exist no features which meet the requirement of independent existence and the instant case is distinguishable from both *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F. 2d 989 (2d Cir. 1980) and *Don Kasoff, Inc. v. Gresco Jewelry Co.*, 204 F. Supp. 694 (S.D.N.Y. 1962) *affirmed per curiam*, 308 F. 2d 806 (2d Cir. 1962).

In accordance with all of the foregoing, it is Ordered and Adjudged:

1. That there is no genuine issue as to any material fact forming the basis of the motion and International Telephone and Telegraph Corporation is entitled to partial summary adjudication in its favor as a matter of law. ITT's motion for partial summary judgment (Document 42 in TCA 80-1027, Document 33 in TCA 81-744) should be, and hereby is, Granted.

2. That there is no genuine issue as to any material fact and Defendant Ladd is entitled to judgment in his favor as a matter of law. The motion for summary judgment in favor of Defendant Ladd (Document 49 in TCA 80-1027) should be, and hereby is, Granted.

Done and Ordered this 12th day of August, 1981.

/s/ William Stafford
Chief Judge

APPENDIX B

OPINION

(United States Court of Appeals, Eleventh Circuit)

(Filed Jan. 4, 1983)

(Norris Industries v. Intern. Tel. & Tel. Corp.)
RONEY, Circuit Judge:

This case involves whether wire-spoked wheel covers for automobiles are entitled to copyright protection as opposed to industrial design or some other trade protection. The district court in this copyright infringement suit concluded on summary judgment that the wheel covers are not entitled to copyright protection because they are useful articles without separable features. We affirm.

There are essentially two issues in the case: (1) whether the wheel covers are useful or ornamental and (2) whether, even if useful, there is separable art work that deserves copyright protection. The difference between the copyright protection sought by the plaintiff and protection as an industrial design primarily lies in the length of time and the scope of protection given.¹ That the wheel covers might be protected under some other law is not before this panel. The sole issue is whether the wheel covers as presented for registration are copyrightable.

¹ Design patents may be issued for three years and six months, seven years, or fourteen years as the applicant elects. 35 U.S.C.A. § 173. Copyright protection endures for 50 or 75 years, depending on the date of the work's creation and whether the copyright was subsisting on the effective date of the 1976 Act. 17 U.S.C.A. §§ 302-304. While a design patent confers an absolute monopoly, 35 U.S.C.A. § 154, a copyright protects against copying. 17 U.S.C.A. § 106. For comparison of these two forms of protection for intellectual property, see *Schnadig Corp. v. Gaines Manufacturing Co.*, 620 F.2d 1166, 1167-68 (6th Cir. 1980).

Background.

In 1975 Norris Industries, Inc. created a design for a wheel cover that simulates a wire wheel and applied to the Copyright Office for copyright registration. The first two applications were rejected. Norris reapplied and pointed out a district court decision that found the design of a lighting fixture to be copyrightable. *Esquire, Inc. v. Ringer*, 414 F.Supp. 939 (D.D.C.1976). The Copyright Office "in line with [its] policy of resolving doubtful cases in favor of registration" then granted copyright registration. In 1977 Norris created a second design. Four applications for copyright registration were submitted and rejected. During this process the D.C.Circuit Court of Appeals reversed *Esquire, Inc. v. Ringer*, 192 U.S.App.D.C. 187, 591 F.2d 796 (1978), *cert. denied*, 440 U.S. 908, 99 S.Ct. 1217, 59 L.Ed.2d 456 (1979). The second wheel cover was rejected by the Copyright Office as a utilitarian article without separable copyrightable aspects on the authority of *Esquire*.²

Late in 1980 Norris instituted suit in the Northern District of Florida against International Telephone and Telegraph Corporation (ITT), alleging copyright and patent infringement. Pursuant to 17 U.S.C.A. § 411(a), the Register of Copyrights joined in the suit as a party

² A second basis for rejection was the Copyright Office's determination that the wheel cover lacked sufficient original authorship to warrant copyright protection. See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857, 97 S.Ct. 156, 50 L.Ed.2d 135 (1976). This ground is not urged by appellees on appeal, and our decision based on the utilitarian nature of the wheel cover makes consideration of it unnecessary.

defendant for the purpose of contesting registrability.³ ITT then filed suit against Norris in a federal court in California for declaratory judgment as to the validity of Norris' copyrights and patents. On Norris' motion, the California suit was transferred to Florida,⁴ and the two suits were consolidated.⁵ Both ITT and the Register moved for partial summary judgment on the copyright counts. The district court granted the two motions and declared both the registered and the unregistered copyrights invalid as a matter of law.

³ Section 411(a) provides:

Subject to the provision of subsection (b), no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

⁴ Under 28 U.S.C.A. § 1404(a) a district court may, for the convenience of parties and witnesses, transfer any civil action to any other district where it might have been brought.

⁵ Rule 42(a) of the Federal Rules of Civil Procedure permits consolidation of actions involving a common question of law or fact.

Applicable Copyright Law

[1] As an initial skirmish the parties disagree on whether the Copyright Act of 1909, ch. 320, 25 Stat. 1075, as amended, or the Copyright Act of 1976, 17 U.S.C.A. §§ 101-810, is applicable to the instant case although we are not sure it makes any difference. Norris' first registered copyright was granted before the January 1, 1978 effective date of the 1976 Act and therefore the 1909 Act applied. Norris also applied for registration of the second wheel cover before January 1, 1978. The transitional and supplementary provisions of the 1976 Act provide that registration shall be made in accordance with the Act as it existed on December 31, 1977, where the deposit application and fee were received before January 1, 1978. Copyright Act of 1976, P.L. No. 94-553, § 109, 90 Stat. 2600 (1976). Therefore, we agree with Norris that the Copyright Act of 1909 applies to questions of registrability.

In any event, the legislative history of the Act of 1976 indicates that Congress endorsed the practice of the Copyright Office under the Act of 1909 as it related to registrability of utilitarian articles. The express congressional intent was merely to clarify the statutory distinction between works of applied art eligible for copyright protection and industrial designs ineligible for protection. H.R.Rep. No. 94-1476, 94th Cong. 2d Sess. 54-55, reprinted in [1976] U.S.Code Cong. & Ad.News 5659, 5667-68. See also *Esquire, Inc. v. Ringer*, 591 F.2d at 803 (1976 Act and its legislative history express congressional understanding of scope of protection for utilitarian articles). The language from existing guidelines and regulations of the Copyright Office was incorporated into the 1976 Act. Under this Act the definition of useful article is "an article having an intrinsic utilitarian function that is not merely to portray

the appearance of the article or to convey information" and includes articles that are normally a part of a useful article. 17 U.S. C.A. § 101. The design of a useful article qualifies as a copyrightable pictorial, graphic, or sculptural work only to the extent that the design incorporates features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.*

Because Congress intended to codify the existing practice of the Copyright Office with respect to the dichotomy between ornamental and useful articles, the 1976 Act and its legislative history are useful aids in interpreting the 1909 Act and regulations adopted pursuant to it. A further reason for noting the identity of treatment of this matter under the 1909 Act and the 1976 Act is to explain why cases arising under the 1976 Act are relevant to this case arising under the 1909 Act.

Important to this litigation is the intended scope of the copyright laws. Congressional authority to provide authors copyright protection for their writings is found in Article I, Section 8 of the Constitution. Without extending copyright protection to the limits of the Constitution, Congress has sought a flexible definition of writings. The 1909 Act gave content to the phrase "writings of an author," Copyright Act, ch. 391, § 4, 61 Stat. 654 (1947), by setting out classes of works eligible for registration including "works of art." *Id.* § 5(g), 61 Stat. 654 (1947).⁶

⁶ The classifications were:

- (a) Books, including composite and cyclopedic works, directories, gazetteers, and other compilations.
- (b) Periodicals, including newspapers.
- (c) Lectures, sermons, addresses (prepared for oral delivery).
- (d) Dramatic or dramatico-musical compositions.
- (e) Musical compositions.

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Under guidelines established by the Copyright Office, a distinction was made between ornamental and useful articles.⁷ Ornamental articles are "all decorative articles designed primarily to beautify, embellish, or adorn," *Compendium of Copyright Office Practices*, 2.8.1.I.b.1., and if the requirements of originality and creativity are satisfied, are entitled to registration. Useful articles are "designed primarily to serve a utilitarian function," *id.* 2.8.1.I.b.2., and are not entitled to registration, except

(continued from preceding page)

- (f) Maps.
- (g) Works of art; models or designs for works of art.
- (h) Reproductions of a work of art.
- (i) Drawings or plastic works of a scientific or technical character.
- (j) Photographs.
- (k) Prints and pictorial illustrations including prints or labels used for articles of merchandise.
- (l) Motion-picture photoplays.
- (m) Motion pictures other than photoplays.
- (n) Sound recordings.

Copyright Act, ch. 391, § 5, 61 Stat. 654 (1947). The 1976 Act denominates copyrightable subject matter as "original works of authorship" and specifies the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.

17 U.S.C.A. § 102(a). The category of pictorial, graphic, and sculptural works is intended to encompass class (f) through (k) of § 5 of the 1909 Act. 1 M. Nimmer, *Nimmer on Copyright*, § 2.08 at 2-74 (1982).

⁷ A regulation drawn in 1910 reads as follows:

Works of art.—This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture.)

Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.

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for features "which can be identified separately and are capable of existing independently as a work of art." 37 C.F.R. § 202.10(c) (1977) [superseded]. As indicated in the above discussion, these regulations were effectively codified in the 1976 Act. 17 U.S. C.A. § 101.

Discussion

Norris contends first that its wheel covers are ornamental articles, not useful, designed to beautify, embellish, and adorn the wheels of automobiles. The district court held that the wheel covers are utilitarian articles serving as hubcaps to protect lugnuts, brakes, wheels, and axles from damage and corrosion, as had been determined by the Register in rejecting the copyright application.⁸ The court added that the wheel covers were designed to be part of an automobile, which is a useful article.

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Rules and Regulations for the Registration of Claims to Copyright, Bulletin No. 15 (1910), 8, cited in *Mazer v. Stein*, 347 U.S. 201, 212 n. 23, 74 S.Ct. 460, 467 n. 23, 98 L.Ed. 630 (1954). In response to *Mazer v. Stein*, which recognized that the incorporation of a work of art into a useful article did not foreclose copyright protection, the Copyright Office promulgated the following regulation:

If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

37 C.F.R. § 202.10(c) (1959), cited in 1 M. Nimmer, *supra*, § 2.08[B][3], at 2-89.

⁸ In response Norris pointed out that the design of its wheel cover allowed passage of road debris through it to the wheel of automobile, and on appeal Norris states that one of its designs lacks the protective backplate. As the Register observes, however, the efficiency of a utilitarian article is irrelevant for copyright purposes.

The district court properly gave some deference to the expertise of the Register in its decision. The Supreme Court has accorded deference to the Register's drawing of the line between ornamental and useful articles. In *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954), the seminal case on the copyrightability of works of art used in industry, the Court referred to the agency's construction of the statute in its regulation permitting registration of works of artistic craftsmanship only as to form and not as to mechanical or utilitarian aspects. *Id.* at 212-13 74 S.Ct. at 467-68. The District of Columbia Circuit has noted the considerable expertise of the Register in defining the boundaries between copyrightable works of art and noncopyrightable industrial designs and has accorded considerable weight to the refusal of registration. See *Esquire, Inc. v. Ringer*, 591 F.2d at 801. The Fourth Circuit has also expressly deferred to the Register's view on the registrability of utilitarian articles. See *Eltra Corp. v. Ringer*, 579 F.2d 294, 297-98 (4th Cir.1978). The expertise relied on is not technical expertise in the use of the article submitted for registration but expertise in the interpretation of the law and its application to the facts presented by the copyright application. The Copyright Office has been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870 characterized copyrightable subject matter as works of fine arts. See *Mazer v. Stein*, 347 U.S. at 209-13, 74 S.Ct. at 466-68.

These determinations are routinely made by the Register and are unquestionably related to the substantive area of the agency's business. Therefore, we find no error in the district court's reliance on the Register's opinion that Norris' wheel covers are useful articles as that term is used in the Act. This is not to say that the Court should simply accept the Register's

decision without question. But our view of the uncontradicted evidence and the graphic description of the wheel cover reveals no abuse of administrative discretion by the Register. See *Esquire, Inc. v. Ringer*, 591 F.2d at 805-06 & n. 28. The Court's statement that it took judicial notice of the history of the automobile hubcap, a statement faulted by Norris, was nothing more than an assessment of the evidence in light of common knowledge and does not require a reversal of the court's decision.

[2] We therefore hold that the district court was correct in deciding that the wirespoked wheel covers are useful within the meaning of the copyright law.

As useful articles any features that can be identified separately and exist independently of the utilitarian aspects of the article may still be copyrighted as a work of art. 37 C.F.R. § 202.10(c) (1977) [superseded]; 17 U.S.C.A. § 101. Both case law and legislative history indicate that separability encompasses works of art that are either physically severable from the utilitarian article or conceptually severable. 1 M. Nimmer, *Nimmer on Copyright*, § 208[B][3], at 2-94—2-96.1 (1982). In a noted case involving physical separability a simulated antique telephone which encased a pencil sharpener was found to be copyrightable. *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F.Supp. 733 (S.D.N.Y.1966). Although the pencil sharpener was a useful article, the telephone casing was physically severable and capable of existing independently as a work of art. The court stressed that "the copyrighted article is the stimulation of an antique telephone, not the pencil sharpener inside, and not the combinatin of the two." *Id.* at 734. Similarly, in *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954), the statuettes used as lamp bases were undeniably capable of

existing as independent works of art. In fact, the dancing figures without any lamp components were first registered as works of art. *Id.* at 202-03, 74 S.Ct. at 462. The Supreme Court held that works of art do not lose their copyrightability when incorporated into a useful article. *Id.* at 218, 74 S.Ct. at 471.

The district court considered the ornamental and utilitarian aspects of Norris' wheel covers to be inseparable. The court noted that the appearance of a wire wheel was conveyed by the entire wheel cover taken as a whole. The record indicates that Norris sought copyright registration for the entire wheel cover. Even if the arrangement of spokes could be identified separately, however, they are incapable of existing independently. As the Register and the district court observed, the pattern resulting from the placement of spokes is an inseparable component of the wheel cover. The spokes are attached to the rim and to the hub, and once the spokes are removed from their position the pattern ceases to exist. See *SCOA Industries, Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216, 218 (S.D.N.Y. 1976) (sculptured design of wavy lines, ridges, and troughs in shoe soles cannot be identified nor exist independently as works of art). Nimmer concludes that "[p]hysical separability would presumably mean that after removal of those features which are necessary for the utilitarian function of the article, the artistic features would nevertheless remain intact." 1 M. Nimmer, *supra*, § 2.08[B][3], at 2-96. Norris emphasizes that the spokes and hub can be removed from the backing plate, but the hub and spokes do not constitute the simulated wire wheel for which copyright protection was sought. See *Esquire, Inc. v. Ringer*, 591 F.2d at 806. Nor do the hub and spokes constitute a feature capable of existing independently as a work of art.

Norris argues that, even if not physically separable, the aesthetically pleasing pattern formed by the spokes is nevertheless conceptually separable. Attempting to draw a line between "copyrightable works of applied art and uncopyrighted works of industrial design," the Committee commented on the conceptually separable elements of useful articles such as a carving on the back of a chair and a floral relief design on silver flatware. H.R.Rep. No. 94-1476, 94th Cong., 2d Sess. 55, *reprinted in* [1976] U.S. Code Cong. & Ad.News 5659, 5668.⁹ These items are ornamental, superfluous designs contained

9

... the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance of an article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the overall configuration of the utilitarian article as such.

H.R.Rep. No. 94-1476, 94th Cong., 2d Sess. 55, *reprinted in* 1976 U.S.Code Cong. & Admin. News 5667, 5668.

within useful objects. See *Scarves by Vera, Inc. v. United Merchants and Mfrs., Inc.*, 173 F.Supp. 625 (S.D.N.Y. 1959) (designs printed on blouses copyrightable); *Syracuse China Corp. v. Stanley Roberts, Inc.*, 180 F.Supp. 527 (S.D.N.Y. 1960) (designs on dinnerware copyrightable).

On the other hand, functional components of useful articles, no matter how artistically designed, have generally been denied copyright protection unless they are physically separable from the useful article. See *Esquire, Inc. v. Ringer*, 192 U.S.App.D.C. 187, 591 F.2d 796 (1978), cert. denied, 440 U.S. 908, 99 S.Ct. 1217, 59 L.Ed.2d 456 (1979) (overall design of lighting fixture not copyrightable); *SCOA Industries, Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (wavy lines on shoe soles not copyrightable); *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 155 F.Supp. 932 (S.D.N.Y. 1957), aff'd in part, reversed on other grounds, 260 F.2d 637 (2d Cir. 1958) (artistically designed watch face not copyrightable). The wire wheel covers in this case are not superfluous ornamental designs, but functional components of utilitarian articles.

In *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), a case "on a razor's edge of copyright law," 632 F.2d at 990, the Second Circuit upheld the Copyright Office's determination that sculptured belt buckles were eligible for copyright protection. The court viewed their primary sculptural elements as "conceptually separable" from their subsidiary utilitarian function. *Id.* at 993. The belt buckles in *Kieselstein-Cord* had been registered by the Copyright Office as jewelry. Unlike the shape of useful articles, the form of jewelry has traditionally been considered copyrightable. See *Boucher v. DuBoyes, Inc.*, 253 F.2d 948, 949 (2d Cir.), cert. denied, 357 U.S. 936, 78 S.Ct. 1384, 2

L.Ed.2d 1550 (1958). Noting this traditional copyright protection of jewelry, the court stated that its conclusion that the sculptured belt buckles were copyrightable was "not at variance with the expressed congressional intent to distinguish copyrightable applied art and uncopyrighted industrial design." *Kieselstein-Cord*, 632 F.2d at 993.

[3] Wire wheel covers do not fall within any of the categories of fine or applied art which have been traditionally considered copyrightable. The wheel covers do not contain a superfluous sculptured design, serving no function, that can be identified apart from the wheel covers themselves. As we have suggested to be appropriate, the court in *Kieselstein-Cord* gave some deference to the Copyright Office's determination that the belt buckles were copyrightable works of art, noting that "[t]he Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted." *Id.* at 994. The Copyright Register here refused to register the wheel covers.

The district court did not err in concluding that the wire wheel covers, as useful articles containing no physically or conceptually separable works of art, are not entitled to copyright protection.

AFFIRMED.

Adm. Office, U.S. Courts—West Publishing Company,
Saint Paul, Minn.

APPENDIX C

ORDER

(In The United States Court of Appeals, Eleventh Circuit)

(Filed March 18, 1983)

(Norris Industries, Inc., Plaintiff-Appellant, versus International Telephone and Telegraph Corporation, and David L. Ladd, Register of Copyrights, Defendants-Appellees — No. 81-5915)

Appeal from the United States District Court for the Northern District of Florida.

PETITION FOR REHEARING AND
SUGGESTION FOR REHEARING EN BANC

(Opinion January 24, 1983, 11 Cir., 198___, ___ F.2d ___).

Before RONEY and HATCHETT, Circuit Judges, and WISDOM*, Senior Circuit Judge PER CURIAM:

(xxx) The Petition for Rehearing is DENIED and no member of this panel nor Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc (Rule 35, Federal Rules of Appellate Procedure; Eleventh Circuit Rule 26), the Suggestion for Rehearing En Banc is DENIED.

ENTERED FOR THE COURT:

/s/ PAUL H. RONEY

United States Circuit Judge

*Honorable John Minor Wisdom, U.S. Circuit Judge for the Fifth Circuit, sitting by designation.

REHG-6

(Rev. 6/82)

APPENDIX D

CONSTITUTIONAL PROVISIONS, STATUTES, AND REGULATIONS INVOLVED IN THIS PETITION

Article I, Section 8 of the Constitution provides in relevant part:

The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

The 1909 Copyright Act, 17 U.S.C. § 5, provides in relevant part:

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs: * * * (g) Works of art; models or designs for works of art.

37 C.F.R. § 202.10(c) (1959) provides:

If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existence independently as a work of art, such features will be eligible for registration.

Section 2.8.1 I.b.1 of the Compendium of Copyright Office Practices provides in relevant part:

Ornamental articles. This category includes all decorative articles designed primarily to beautify, embellish, or adorn

Section 2.8.1 I.b.2 of the Compendium of Copyright Office Practices provides in relevant part:

Useful articles. This category includes all articles designed primarily to serve a utilitarian function

Section 2.8.3 I.b. of the Compendium of Copyright Office Practices provides in relevant part:

Sculptural material. Class G is appropriate for the registration of original sculpture which embodies creative authorship expressed in three-dimensional form by means of carving, casting, cutting, molding, shaping, or otherwise processing plastic or hard materials. Creative sculptural authorship may be expressed in the form, or the peripheral outline of whatever has been given a three-dimensional form or shape.

Section 2.8.3 I.d. of the Compendium of Copyright Office Practices provides in relevant part:

Utilitarian articles. The copyrightability of a work of art is not affected by the fact that the work may also embody utilitarian features, or that it may itself be embodied in an article of utility. In all cases, registration must be based upon those copyrightable features such as artistic sculpture, carving, or pictorial representation which can be identified separately and are capable of existing independently as a work of art, as for example: (1) a statuette used as a base for a table lamp, (2) an original painting reproduced on a porcelain dinner plate, (3) a sculptured figure used as a handle for a letter opener, (4) an artistic design reproduced on textile fabric, or (5) a stained glass window.

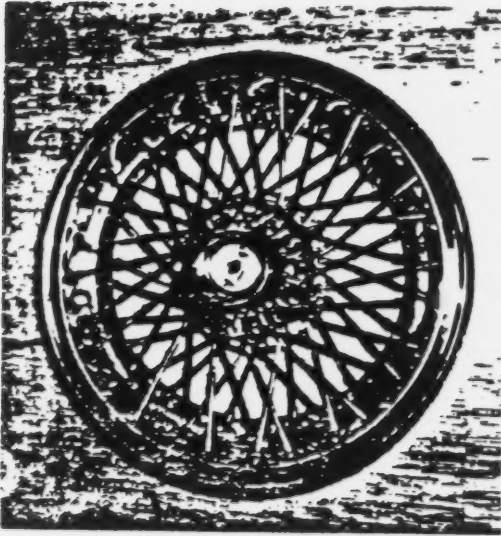
Section 101 of the 1976 Copyright Act, 17 U.S.C. § 101, provides in relevant part:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

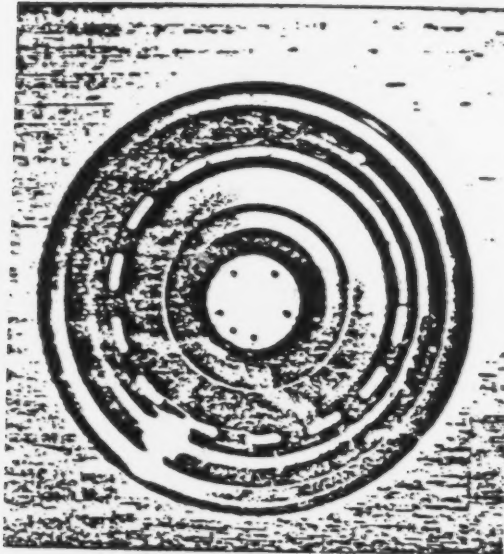
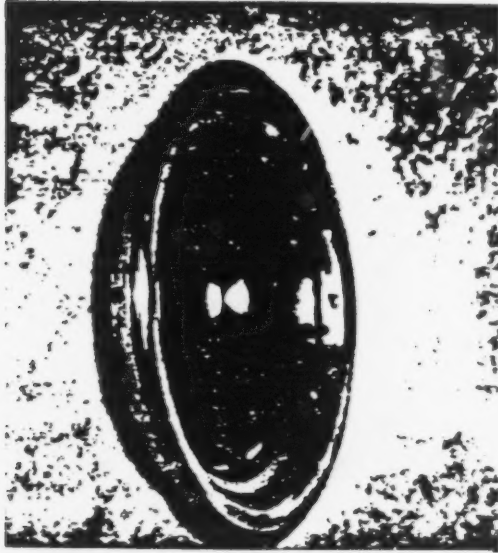
E-3

NORRIS Photograph Of Record
(Vol. 5, p. 795)

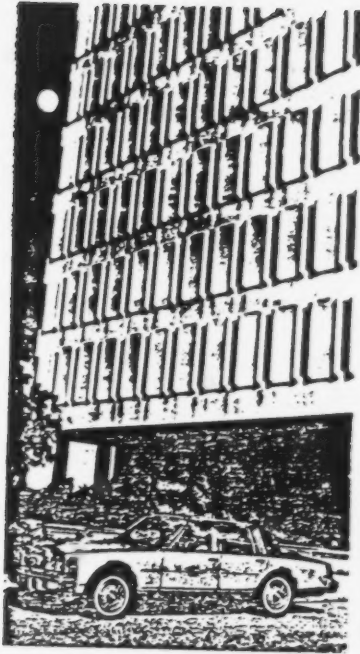


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NORRIS Photographs Of Record
(Vol. 5, p. 794)



NORRIS Photograph Of Record
(Vol. 5, p. 804)

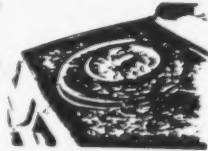


The Luxury Seville...

Phase II

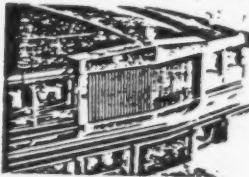
This... is the ultimate Seville!

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To top off this "design experience" we have added Astro-roof, the retractable roof that brings the outside world inside, open or closed, through glass that can be color keyed to the exterior of your Seville.



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APPENDIX F

LEGISLATIVE HISTORY OF 17 U.S.C. § 101 OF THE 1976
COPYRIGHT ACT, H.R. REP. NO. 1476, 94th CONG., 2d
SESS. 55 (1976), 1976 U.S. CODE CONG. & ADMIN. NEWS
5659, 5668

The 1976 Copyright Act, 17 U.S.C. § 101, definition of "pictorial, graphic and sculptural works" is an adapted codification of 37 C.F.R. § 202.10(c), the Copyright Office Regulation adopted under the 1909 Act in the mid-1950's in an effort to implement this Court's decision in *Mazer v. Stein*, 347 U.S. 201, 74 S. Ct. 460, 98 L.Ed.630 (1954), when the Court last dealt with the copyrightability of sculptural works of art. The legislative history of this definition indicates:

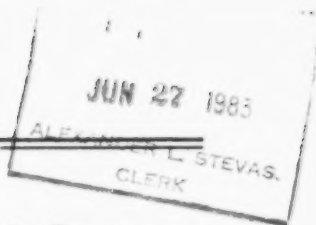
"A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill." (Emphasis added.)

No. 82-1880

IN THE

Supreme Court of the United States

October Term, 1982



NORRIS INDUSTRIES, INC.,

Petitioner,

v.

INTERNATIONAL TELEPHONE
AND TELEGRAPH CORPORATION,

and

DAVID L. LADD, REGISTER OF COPYRIGHTS,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

John E. Kidd

(Counsel of Record)

Robert M. Kunstadt

PENNIE & EDMONDS

330 Madison Avenue

New York, New York 10017

(212) 986-8686

Of Counsel:

Michael J. Cronin

Paul W. Hemminger

Ronald W. Alice

International Telephone and
Telegraph Corporation

320 Park Avenue

New York, New York 10022

(212) 940-1630

TABLE OF CONTENTS

	PAGE
Table of Authorities	ii
Counter-Statement of the Case	2
Summary of the Argument	2
Argument.....	3
I. The Circuit Courts Uniformly Recognize The Congressional Mandate That Works of Industrial Design Such as Wheel Covers are Uncopyrightable.....	3
II. Summary Judgment Here Accords With Due Process.....	5
Conclusion	7
Appendix - Corporate Parents, Non-wholly Owned Subsidiaries, and Affiliates of International Telephone and Telegraph Corporation.....	A-1

TABLE OF AUTHORITIES

	PAGE
Cases	
<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U.S. 239 (1903).....	4
<i>Brown v. Piper</i> , 91 U.S. 37 (1875).....	6
<i>Esquire, Inc. v. Ringer</i> , 591 F.2d 796 (D.C. Cir. 1978).....	3,6
<i>Fame Publishing Co., Inc. v. Alabama Custom Tape, Inc.</i> , 507 F.2d 667 (5th Cir. 1975)	5
<i>Graham v. John Deere</i> , 383 U.S. 1 (1966).....	3
<i>Janex Corporation v. Bradley Time</i> , 460 F. Supp. 383 (S.D.N.Y. 1978)	5
<i>Kieselstein-Cord v. Accessories by Pearl, Inc.</i> , 632 F.2d 989 (2d Cir. 1980)	4
<i>Mazer v. Stein</i> , 347 U.S. 201 (1954).....	4,6
<i>Ronel Corporation v. Anchor Lock of Florida, Inc.</i> , 325 F.2d 889 (5th Cir. 1963), <i>cert. den.</i> , 377 U.S. 924 (1964).....	5
<i>Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.</i> , 95 F.R.D. 95 (D. Del. 1982)	4,6
<i>United States v. Various Slot Machines on Guam</i> , 658 F.2d 697 (9th Cir. 1981).....	5
Rules and Regulations	
37 C.F.R. §202.10(c) [superseded]	2
Rule 35, F.R.A.P.	2
Rule 56, F.R.Civ.P.	3,5
Other	
Congressional Record H. 31979 (September 22, 1976).....	4
H.R. Report No. 1476, 94th Congress Second Session 50 (1976).....	2,4

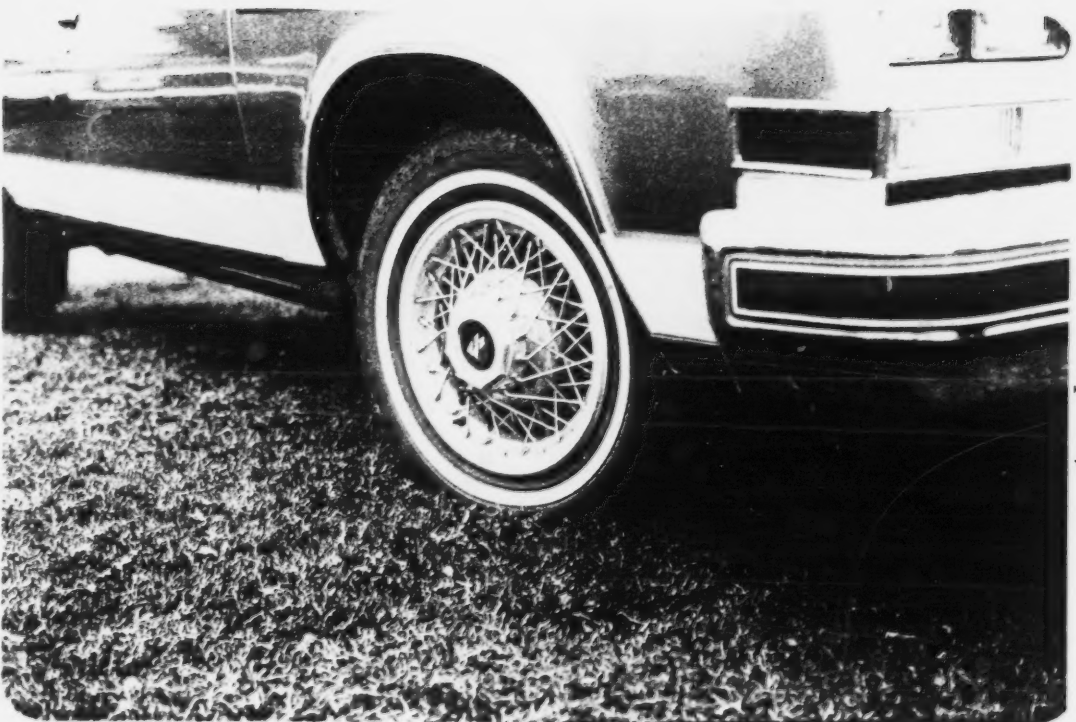
E-1

NORRIS Photograph Of Record
(Vol. 4, p. 639)



E-2

NORRIS Photograph Of Record
(Vol. 4, p. 641)



IN THE
Supreme Court of the United States
OCTOBER TERM, 1982

NORRIS INDUSTRIES, INC., *Petitioner,*
v.
INTERNATIONAL TELEPHONE AND TELEGRAPH CORPORATION
and
DAVID L. LADD, REGISTER OF COPYRIGHTS, *Respondents.*

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

Norris' Petition for a Writ of Certiorari raises no genuine issue requiring this Court's attention. The Copyright Office and the courts below unanimously rejected Norris' copyright claims in wheel covers (hubcaps), since they are utilitarian industrial designs, are not works of art and do not possess any independent and separable features identifiable as works of art. They are not entitled to an effective 75 to 100 year monopoly under the copyright statute.*

* Note: See Appendix for listing of Corporate Parents, Subsidiaries, and Affiliates of International Telephone and Telegraph Corporation.

COUNTER-STATEMENT OF THE CASE

Norris' statement of the case is argumentative and assumes facts not in evidence.¹ An unbiased statement of the case is found in the Eleventh Circuit's opinion (as reproduced in the Norris Petition, pp. B-2 to B-3). The Eleventh Circuit's three-judge panel unanimously affirmed the district court's judgment. Norris petitioned for rehearing *en banc*, which was denied by order of March 18, 1983. Not a single judge requested that the court be polled pursuant to Rule 35, F.R.A.P. The mandate issued on April 19, 1983. Norris sought neither stay nor recall of the mandate, so the case is now before the district court for further proceedings.

SUMMARY OF THE ARGUMENT

The Copyright Office and the courts below unanimously agree that Norris' copyright claims are a meritless attempt to secure a monopoly on industrial designs for wheel covers. This is expressly forbidden by the copyright statute, which protects works of art, but not industrial designs. Congress, in enacting the current statute, intended "to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design".² The courts below found beyond dispute that Norris' wheel covers fell on the industrial design side of the line, and granted summary judgment invalidating Norris' copyright claims.

The courts below fully considered the decisions of other circuits and explained that their opinions harmonize with precedent, which uniformly holds that works of industrial design such as wheel covers are uncopyrightable.

¹ For example, the Norris Petition (p. 6) states as a fact that ITT copied Norris' designs. No such fact has been established by Norris or conceded by ITT. Also, Norris incorrectly implies that 37 C.F.R. §202.10(c) as reproduced in the Norris Petition (p. D-1) is still in force.

² H.R. Rep. No. 1476, 94th Congress, 2d Session 55 (1976) (as reproduced in Norris Petition, p. B-11 n. 9).

Summary judgment was proper since Norris raised no genuine issue of material fact; Norris cannot seriously contend that the summary judgment procedure, as established by Rule 56, F.R.Civ.P., is itself a violation of due process.

Norris' theory that the obviousness standard for issuance of a patent under *Graham v. John Deere*, 383 U.S. 1 (1966), somehow should be extended to issuance of a *copyright* on an alleged work of art only highlights the fact that Norris' wheel covers should be protected, if at all, only under the patent law.³ While patent law affords a maximum monopoly term of seventeen years, copyright (if afforded to industrial designs as urged by Norris) would provide an effective 75 to 100 year monopoly.

ARGUMENT

I. The Circuit Courts Uniformly Recognize the Congressional Mandate That Works of Industrial Design Such as Wheel Covers Are Uncopyrightable.

The automotive wheel covers in suit are not copyrightable because they are nothing more than industrial designs of a useful article, rather than works of art. Congress did not intend such industrial designs to be afforded copyright protection. Congress since 1914 has repeatedly rejected approximately 70 design protection bills that would have made copyright protection available for industrial designs.⁴

A proposed Title II of the Copyright Act of 1976 (which would have provided for copyright in industrial designs) was deleted from the final bill because of a strong objection by the Justice Department to "creation of [a] new form of intellectual property" and a concern over the anticompetitive effects inherent in granting a 75 to 100 year monopoly over the design of consumer

³ Norris' theory is so tenuous as to require no further comment.

⁴ See discussion in the leading case *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n. 12 and n. 13 and text (D.C. Cir. 1978).

goods. H.R. Report No. 1476, 94th Congress Second Session 50 (1976); Congressional Record H. 31979 (September 22, 1976).

The decision of the Second Circuit in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), does not contradict the established principle that works of industrial design such as wheel covers are uncopyrightable. As explained by the Eleventh Circuit,⁵ the Second Circuit in *Kieselstein*, in a decision admittedly "on a razor's edge",⁶ considered the facts that (a) the Copyright Office had granted registrations to the belt buckles there in issue and (b) the buckles fell within the category of jewelry, which has traditionally been regarded as copyrightable, to support a finding of copyrightability. No comparable facts are present here.⁷

Importantly, the Norris wheel covers were not denied copyright because they do not fall within the traditional definition of art, but because they do not fall within *any* definition of art (as opposed to industrial design) recognized by the statute. The *Kieselstein* jewelry, falling as it did within the traditional definition of art, was not uncopyrightable industrial design.

That a particular category of work, such as jewelry, has traditionally been regarded as copyrightable applied art rather than uncopyrightable industrial design does not violate the *Bleistein* precept not to deny copyright to an individual work based on lack of artistic merit.⁸ Neither the District Court nor the Elev-

⁵ As reproduced in the Norris Petition, p. B-12.

⁶ 632 F.2d at 990.

⁷ There is no conflict between the circuits—the Second Circuit found the buckles primarily ornamental and hence conceptually separable because they were worn as jewelry on the body, a well-recognized type of copyrightable work. The Norris hubcaps are not jewelry. Even if a single district judge in *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D. Del. 1982), allegedly failed to appreciate the harmony between *Esquire* and *Kieselstein*, this cannot create a conflict between the circuits where none exists.

⁸ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); *Mazer v. Stein*, 347 U.S. 201 (1954). These opinions precluding denial of copyright based on lack of artistic merit are not in issue, because Norris' copyright claims were rejected as not falling within *any* definition of art (as opposed to uncopyrightable industrial design), not because they lacked artistic merit under "traditional" standards.

enth Circuit made any comment, one way or the other, on the alleged artistic merit of Norris' wheel covers. It is the statute itself, forbidding copyright registration for the overall category of industrial designs, which led to rejection of Norris' copyright claims.⁹

II. Summary Judgment Here Accords With Due Process.

Norris cannot seriously contend that the summary judgment procedure established by Rule 56, F.R.Civ.P., and applied here violates due process. Norris' claims were fully considered and soundly rejected by:

- a) The Copyright Office (four times);
- b) The District Court;
- c) A unanimous three judge panel of the Eleventh Circuit; and
- d) All the sitting judges of the Eleventh Circuit, in denying Norris' petition for rehearing *en banc*.

Norris' affidavits by persons styled as experts suffice neither to establish a disputed genuine issue of material fact, nor automatically to preclude summary judgment. *United States v. Various Slot Machines on Guam*, 658 F.2d 697, 700 (9th Cir. 1981); *Fame Publishing Co., Inc. v. Alabama Custom Tape, Inc.*, 507 F.2d 667, 672 (5th Cir. 1975); *Ronel Corporation v. Anchor Lock of Florida, Inc.*, 325 F.2d 889 (5th Cir. 1963), *cert. den.*, 377 U.S. 924 (1964); *Janex Corporation v. Bradley Time*, 460 F.Supp. 383 (S.D.N.Y. 1978). Nor can they preclude judicial

⁹ Norris' insistence that the Copyright Office must consider scientific testimony to determine whether the Norris hubcaps are useful objects is clearly impractical, in view of the tens of thousands of copyright applications which must be processed monthly. The Copyright Office is entitled to make an administration determination that certain types of articles (such as hubcaps) are utilitarian, without making a scientific inquiry into the efficiency of any particular hubcap design. The efficiency of the Norris hubcaps is of no moment, as recognized by the Eleventh Circuit (Norris Petition, p. B-7 n. 8).

notice of facts of common knowledge, *Brown v. Piper*, 91 U.S. 37, 43 (1875), such as the utilitarian nature of hubcaps.¹⁰

Contrary to Norris' implications, the courts below did not render uncritical deference to the decision of the Copyright Office that Norris' wheel covers are unregistrable. The practice of the Copyright Office is entitled to great weight. See, e.g., *Mazer, supra*, 347 U.S. at 213. As aptly stated by Circuit Judge Leventhal (concurring):

"The subject-matter of copyrights is such as to suggest that rarely if ever will a ruling denying an application for copyright on the basis of the application of a regulation be considered a contravention of a duty owed to the applicant. There is jurisdiction but no large likelihood of successful invocation". *Esquire, supra*, 591 F.2d at 808.

¹⁰ That a district judge in another case (*Trans-World, supra*), on facts different from those here, exercised his discretion under Rule 56, F.R.Civ.P., to deny summary judgment, does not preclude summary judgment here. ITT and the Copyright Office need only show that summary judgment was proper in this case (as they have done), and not that summary judgment is proper in all other copyright cases involving alleged works of art. Note that the plaintiff copyright claimant in *Trans-World* has since dismissed its copyright cause of action. Letter Ruling of April 7, 1983, *Trans-World Mfg. Corp. v. Al Nyman & Sons*, C.A. 81-471, D. Del. (Wright, J.) (unreported).

CONCLUSION

The Norris petition is plainly frivolous and should be summarily denied.

Respectfully submitted,

John E. Kidd

PENNIE & EDMONDS

Counsel of Record for Respondent

Of Counsel:

Robert M. Kunstadt
PENNIE & EDMONDS
330 Madison Avenue
New York, New York 10017
(212) 986-8686

Michael J. Cronin
Paul W. Hemminger
Ronald W. Alice
International Telephone and
Telegraph Corporation
320 Park Avenue
New York, New York 10022
(212) 940-1630

APPENDIX

Corporate Parents, Non-wholly Owned Subsidiaries, and Affiliates of International Telephone and Telegraph Corporation:*

Abbey Life Insurance Company of Canada, Amar Hotel Investment Corp., Atlanta Hotel Associates, Bell Zaire Szarl, Cannon/Jae Ltd., Compania Internacional de Telecomunicacion y Electronica SA, Compania Standard Electrica Argentina, Continental de Alimentos, Convention Plaza East Hotel, El Conquistador Hotel Associates, Elektro-Treuhand GmbH, Excess Underwriting Management GmbH, F.A. Knight & Son S.A., Fabrica de Equipo de Telefonos SA (FETSA), Far East Switches Ltd., Federal Electric Alireza Ltd., Feuerbacher Volksbank, Friedrich Grohe Armaturenfabrik GmbH & Co., Gallital Iberica SA, Globe Mackay Cable & Radio Corp., Grays Harbor Paper Co., Grohe Handelsgesellschaft mbH, Grundstücksgemeinschaft L'Orange, Kunzler, Knauer, Hotels Sheraton de Portugal Sarl, H.W. Liebrich GmbH, Industria de Telecomunicacion, Interessengemeinschaft fur Rundfunkrechte, International Telecommunication Center SA, ITT Composants Et Instruments, ITT Comunicaciones Mundiales SA (Chile), ITT Maroc Limited, ITT Niles Co. Inc., ITT Switches (WK) Limited, ITT World Directories (U.K.) Ltd., ITT World Directories Inc., Kabeltrommel GmbH, London-Canada Insurance Company, Maister Directories Pty. Ltd., Marconi Espanola S.A., Metalicht, B.V., Metalicht N.V., Munchener Autozubehor GmbH, Munchner Motorzubehor GmbH, National Continental Corporation, Ltd., Private Investor Co., Promedia SA, Publimedia BV, Riverpark Development Co., Schmoele & Comp., Sheraton Tunisia Management Corporation, SKI Times Square Enterprises, SNV Studiengesellschaft f. Nahverkehr GmbH, Sistemas de Bombeo SA de CV, Sociedad Inmobiliaria San Cristobal SA, Sociedad Industrial de Electromagnetismo Sarl, Societe d'Exploitation des Cables Electriques, Societe de Materiel Montparnasse Sod-

* Defined in accordance with SEC Regulations, 17 CFR §240.12b-2.

evan & Cie SA, Societe Immobiliere Hoteleliere Montparnasse S.A., Southwest Producing Company of Canada Limited, Standard Electric Alireza Limited (Seal), Standard Elektrik Lorenz AG (Sel), Standard Electric S.A. (Spain), Standard Telefon Og Kabelfabrik AS (STK), Standard Telephones and Cables Public Limited Company, Suez Electronics S.A.E., Taiwan International Standard Electronics, Ltd., Teleannons Ab., Telephone Electronic Machines S.A., Wilton, Sutter and Co., Wonder del Centro S.A. de C.I. Mexico.

No. 82-1880

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In the Supreme Court of the United States

OCTOBER TERM, 1983

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CORPORATION, ET AL.

*ON PETITION FOR A WRIT OF CERTIORARI TO
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BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

REX E. LEE

Solicitor General

J. PAUL McGRATH

Assistant Attorney General

ANTHONY J. STEINMEYER

JOHN FARGO

Attorneys

Department of Justice

Washington, D.C. 20530

(202) 633-2217

QUESTION PRESENTED

Whether the court of appeals correctly found that petitioner's wheel covers are not copyrightable because they are useful articles containing no independent and separable works of art.

TABLE OF CONTENTS

	Page
Opinions below	1
Jurisdiction	1
Statement	1
Argument	5
Conclusion	9

TABLE OF AUTHORITIES

Cases:

<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U.S. 239	6
<i>Durham Industries, Inc. v. Tomy Corp.</i> , 630 F.2d 905	5, 6
<i>Eltra Corp. v. Ringer</i> , 579 F.2d 294	5, 7
<i>Esquire, Inc. v. Ringer</i> , 414 F. Supp. 939, rev'd, 591 F.2d 796, cert. denied, 440 U.S. 908	2, 5, 6, 7
<i>Graham v. John Deere Co.</i> , 383 U.S. 1	8
<i>Kieselstein-Cord v. Accessories by Pearl, Inc.</i> , 632 F.2d 989	5, 6, 7
<i>Mazer v. Stein</i> , 347 U.S. 201	5, 6
<i>Patagonia Corp. v. Board of Governors</i> , 517 F.2d 803	7
<i>Ronel Corp. v. Anchor Lock of Florida, Inc.</i> , 325 F.2d 889, cert. denied, 337 U.S. 924	8
<i>SCOA Industries, Inc. v. Famolare</i> , 192 U.S.P.Q. (BNA) 216	5, 6

IV

Page

Cases—Continued:

<i>Ted Arnold Ltd. v. Silvercraft Co.</i> , 259 F. Supp. 733	5
<i>Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.</i> , 95 F.R.D. 95	7, 8
<i>Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.</i> , 155 F. Supp. 932, aff'd in part and rev'd in part on other grounds, 260 F.2d 637	8

Statutes and regulation:

Copyright Act of 1909, 17 U.S.C. 1 <i>et seq.</i>	4
Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541, 17 U.S.C. (& Supp. V) 101 <i>et seq.</i>	4
17 U.S.C. (Supp. V) 409	7
17 U.S.C. (Supp. V) 410	7
17 U.S.C. (Supp. V) 411(a)	3
35 U.S.C. 103	8
37 C.F.R. 202.10(c) (1960)	3, 6

Miscellaneous:

H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. (1976)	7
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BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. B-1 to B-13) is reported at 696 F.2d 918. The opinion of the district court (Pet. App. A-1 to A-6) is reported at 212 U.S.P.Q. (BNA) 754.

JURISDICTION

The judgment of the court of appeals was entered on January 24, 1983, and a petition for rehearing was denied on March 18, 1983 (Pet. App. C-1). The petition for a writ of certiorari was filed on May 17, 1983. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

Petitioner seeks review of the decision of the court of appeals, affirming the judgment of the United States District Court for the Northern District of Florida, that

petitioner's wheel covers are not entitled to copyright protection.

1. The articles involved in this case are covers or hubcaps designed for use on automobile wheels (Pet. App. E-1, E-2). In 1975, petitioner filed an application with the Copyright Office for copyright registration of its first design for a wheel cover. This and a second application were rejected because the subject matter was considered to be uncopyrightable.¹ In a third application, petitioner noted a recent district court decision, *Esquire, Inc. v. Ringer*, 414 F. Supp. 939 (D.D.C. 1976), rev'd, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), in which a refusal to register a lighting fixture was overturned. Petitioner argued, on the basis of this decision, that its application for copyright registration should be allowed (4 C.A. App. 689). In response, the Copyright Office granted registration "in line with [its] policy of resolving doubtful cases in favor of registration" (*id.* at 690-691). Pet. App. A-1 to A-2, B-2.

In 1977, petitioner filed the first of four applications for copyright registration of a second wheel cover design. While these applications were pending, the United States Court of Appeals for the District of Columbia Circuit reversed the lower court decision in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (1978). Petitioner's applications were subsequently rejected because petitioner's wheel covers lacked originality and were useful articles containing no separable works of art. Pet. App. A-2, B-2.

¹In a letter accompanying its second application, petitioner argued that while "many wheel covers have a utilitarian function to protect the lug nuts and hub of the wheel from dirt, mud, debris and the like," its wheel covers did not because these substances could pass through the spokes and slots in the back of the wheel cover (4 C.A. App. 654-655). ("C.A. App." refers to the appendix filed in the court of appeals.)

In 1980, petitioner sued respondent International Telephone & Telegraph Corp. (ITT) for patent infringement and infringement of its registered and unregistered copyrights. See 17 U.S.C. (Supp. V) 411(a). The Register of Copyrights entered that suit as a party defendant on the issue of registrability. ITT subsequently filed a declaratory judgment suit to invalidate petitioner's copyrights, and this second action was consolidated with the suit filed by petitioner.² ITT and the Register filed motions for summary judgment contending that the wheel covers were uncopyrightable because they were useful articles containing no separable works of art. Pet. App. A2, B-2 to B-3.

2. The district court granted both motions for summary judgment (Pet. App. A-1 to A-6). The court first noted that the refusal of the Copyright Office to register a work will not be overturned unless that refusal constitutes an abuse of discretion (*id.* at A-2). It then recognized that in the Copyright Act of 1976, 17 U.S.C. (& Supp. V) 101 *et seq.*, Congress had codified the longstanding position of the Copyright Office that a useful article is uncopyrightable unless it contains some independent and separable work of art (Pet. App. A-2 to A-4).³

In applying the above law to the undisputed facts of this case, the district court found that "the Register's categorization of simulated wire wheel covers as 'useful articles' * * *

²Petitioner's action for infringement of a patent relating to the wire-spoked wheel covers is still pending in the district court.

³Sec. *e.g.*, 37 C.F.R. 202.10(c) (1960):

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of an utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

[was] logical and proper" because they provide "some degree of protection to lug nuts, brakes, the wheel, and the axle" (Pet. App. A-4). It further found that there was no physically or conceptually separable work of art embodied in the wheel covers because the pattern formed by the spokes cannot exist apart from the wheel cover and "[t]he simulation of a wire wheel, which [petitioner] seeks to copy-right, is not created by the spokes * * *, but by the entire wheel cover" (*id.* at A-6).

3. The court of appeals affirmed the grant of summary judgment (Pet. App. B-1 to B-13). The court of appeals noted that two issues were presented by the case: "whether the wheel covers are useful or ornamental" and, if useful, whether "there is a separable art work that deserves copyright protection" (*id.* at B-1).⁴ It held that the district court had correctly found that the wire-spoked wheel covers are useful articles (*id.* at B-9),⁵ and then took up the issue of whether the wheel covers contained a separable work of art. The court noted that the wheel covers could be copyrighted if they embodied a work of art that was "either physically severable from the utilitarian article or conceptually severable" (*ibid.*), but found that petitioner's wheel covers met neither test. The court reasoned that "[e]ven if the arrangement of spokes could be identified separately," that arrangement is incapable of separate existence from the utilitarian

⁴The court of appeals held that the law applicable to this case was the Copyright Act of 1909, 17 U.S.C. 1 *et seq.* (amended by 90 Stat. 2541 *et seq.*), but, like the district court, concluded that the Copyright Act of 1976, 17 U.S.C. (& Supp. V) 101 *et seq.*, recodified existing law regarding copyrightability of useful articles (Pet. App. B-4 to B-5).

⁵The court of appeals concluded that the district court had properly deferred to the Register's determination that petitioner's wheel covers are useful articles. Although a district court should not "simply accept the Register's decision without question," the court of appeals observed that the "uncontradicted evidence and the graphic description of the wheel covers reveals [*sic*] no abuse of administrative discretion by the Register" (Pet. App. B-8 to B-9).

hub cap because "once the spokes are removed from their position the pattern ceases to exist" (*id.* at B-10). The court further held that the legislative history of the Copyright Act of 1976 indicated that conceptually separable works of art include only superfluous designs on useful articles, such as the carving on the back of a chair, that, while not physically severable, constitute independent works of art (Pet. App. B-11 to B-12). The court concluded that petitioner's wire wheel covers "are not superfluous ornamental designs, but functional components of utilitarian articles" and such articles, "no matter how artistically designed, have generally been denied copyright protection" (*id.* at B-12).

ARGUMENT

The decision below is correct, does not conflict with any decision of this Court or of any other court of appeals, and does not warrant further review.

1. The court of appeals affirmed the judgment of the district court because it agreed with the district court's findings that petitioner's wheel covers are useful articles that have no features capable of separate identification and independent existence. These conclusions were based upon and are entirely consistent with the decisions of other courts that have considered the question of copyrightability of useful articles. *Mazer v. Stein*, 347 U.S. 201 (1954); *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Esquire, Inc. v. Ringer, supra*; *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978); *SCOA Industries, Inc. v. Famolare*, 192 U.S.P.Q. (BNA) 216 (S.D. N.Y. 1976); *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966).⁶

⁶In *Mazer v. Stein, supra*; *Ted Arnold Ltd. v. Silvercraft Co., supra*; and *Kieselstein-Cord v. Accessories by Pearl, Inc., supra*, a certificate of registration was issued, and the courts decided in favor of copyrightability. In *Esquire, Inc. v. Ringer, supra*, and *Eltra Corp. v. Ringer,*

There is no discernible difference between petitioner's contentions here and the contention rejected in *Esquire, Inc. v. Ringer, supra*, that a modernistic light fixture is copyrightable.⁷ The appellate court did not, as petitioner suggests (Pet. 11-12), deny copyright protection on the ground that its wheel covers are not within the scope of the traditional fine arts. Rather, the court simply concluded that petitioner's wheel covers are useful articles that do not embody a superfluous ornamental design conceptually separable from their utilitarian function (Pet. App. B-12). Cf. *Kieselstein—Cord v. Accessories by Pearl, Inc., supra*, 632 F.2d at 993 (sculptural elements of jewelry are conceptually separable from the subsidiary utilitarian function of jewelry).

2. Despite petitioner's protestations (Pet. 15-23), the courts have uniformly deferred to the Copyright Office's expertise in drawing the line between copyrightable works of art and uncopyrightable useful articles. See, e.g., *Mazer v. Stein, supra*, 347 U.S. at 213. Thus, the court below did not err in according deference to the Copyright Office's determination in this case.⁸

supra, registration was refused, and the courts held the works uncopyrightable. In *Durham Industries, Inc. v. Tomy Corp., supra*, and *SCOA Industries, Inc. v. Famolare, supra*, certificates of registration had been issued, but the courts decided that the copyrights had not been infringed.

⁷In *Esquire, Inc. v. Ringer, supra*, 591 F.2d at 805, the court of appeals addressed and rejected the argument, raised by petitioner (Pet. 13-15), that the Copyright Office's construction of 37 C.F.R. 202.10(c) (1960) runs counter to the principles enumerated in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). The Court denied certiorari in *Esquire* (440 U.S. 908 (1979)), and petitioner has presented no compelling reason for the Court to grant review here.

⁸The uniform deference accorded to the Copyright Office's determinations is demonstrated by the results reached in the decided cases. See note 6, *supra*. Contrary to petitioner's argument (Pet. 19-22), the fact that the Copyright Office registered one of its wheel designs does not

Petitioner's argument (Pet. 17) that principles of administrative law require an evidentiary hearing to determine if its wheel covers are uncopyrightable useful articles is without basis. *Patagonia Corp. v. Board of Governors*, 517 F.2d 803 (9th Cir. 1975), relied upon by petitioner (Pet. 16), is inapposite in the copyright context. In *Patagonia*, the court held that the Board of Governors of the Federal Reserve System could not resolve disputed factual issues by studying affidavits because its governing statute required the Board to make such determinations after notice and hearing. 517 F.2d at 815-816. Neither the Copyright Act of 1909 nor the Copyright Act of 1976, however, requires the Copyright Office to hold an evidentiary hearing to resolve disputed questions of copyrightability. The Copyright Office has traditionally relied upon its examination of the application and accompanying illustrations or specimens of the work to resolve such questions.⁹

3. The court of appeals correctly affirmed the grant of summary judgment in this case. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, *supra*; *Eltra Corp. v. Ringer*, *supra*; and *Esquire, Inc. v. Ringer*, *supra*, the issue of copyrightability was resolved on summary judgment.¹⁰ The

furnish a basis for refusing to accord that usual deference to the Copyright Office's final determination in this case. The registration of petitioner's wheel cover was made under the Copyright Office's "rule of doubt" in the wake of the district court ruling in *Esquire*—a ruling that was later reversed on appeal. The registration, therefore, does not demonstrate inconsistency on the part of the Copyright Office, but rather highlights the Copyright Office's continuing efforts to comply with what it perceives to be the dictates of controlling law.

⁹See 17 U.S.C. (Supp. V) 409, 410; H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 155-156 (1976). See also *Esquire, Inc. v. Ringer*, *supra*, 591 F.2d at 806.

¹⁰The only decision cited by petitioner in which a court refused to decide this issue on summary judgment is *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95 (D. Del. 1982). That court,

uncontroverted evidence in this case, including the photographs reproduced in the petition (Pet. App. E-1, E-2), clearly establish that petitioner's wheel covers afford some protection to the wheels they cover. Petitioner's affidavits merely question the efficiency with which the wheel covers perform this useful function and do not raise a question of material fact. See *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 155 F. Supp. 932, 934-935 (S.D.N.Y. 1957), aff'd in part and rev'd in part on other grounds, 260 F.2d 637 (2d Cir. 1958).¹¹

however, found "no basis * * * for inference that the Copyright Office considered the separability issue in rejecting Trans-World's copyright application" (95 F.R.D. at 98 n.7), and the case is therefore distinguishable from the present litigation where the Copyright Office expressly considered the separability issue. Moreover, subsequent to the Register's intervention in *Trans-World*, the plaintiff voluntarily dismissed its copyright claim, thereby avoiding a ruling on the Register's motion for summary judgment. Thus, *Trans-World* does not establish that expert testimony is essential to the ultimate resolution of the separability issue.

¹¹Petitioner's attempt to show error by analogizing the determination below to a determination of obviousness under 35 U.S.C. 103 must also fail (Pet. 24-25). Patents have been properly held invalid for obviousness on summary judgment where the underlying facts relating to the inquiries required by *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), were not in dispute. See, e.g., *Ronel Corp. v. Anchor Lock of Florida, Inc.*, 325 F.2d 889 (5th Cir. 1963), cert. denied, 377 U.S. 924 (1964).

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

REX E. LEE

Solicitor General

J. PAUL McGRATH

Assistant Attorney General

ANTHONY J. STEINMEYER

JOHN FARGO

Attorneys

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In the Supreme Court of the United States

OCTOBER TERM, 1982

NORRIS INDUSTRIES, INC.

Petitioner,

v.

INTERNATIONAL TELEPHONE AND TELEGRAPH CORPORATION
and

DAVID L. LADD, REGISTER OF COPYRIGHTS

Respondents.

PETITIONER'S REPLY BRIEF TO BRIEFS OF RESPONDENTS IN OPPOSITION

Joseph R. Papp
Charles H. Blair
John A. Sinclair
HARNES, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 642-7000

Counsel for Petitioner

Of Counsel:

R. James Shaffer
NORRIS INDUSTRIES, INC.
One Golden Shore
Long Beach, Calif. 90802
(213) 435-6676

TABLE OF CONTENTS

	PAGE
TABLE OF AUTHORITIES	ii
I. THE SOLICITOR GENERAL ERRS IN SUGGESTING THAT NORRIS' DISCRIM- INATION CLAIM WAS REJECTED IN ESQUIRE V. RINGER	2
II. RESPONDENTS HAVE FAILED TO JUSTI- FY THE DECISION BELOW, WHICH SUM- MARILY AFFIRMS AGENCY DETERMI- NATIONS MADE WITHOUT EVIDENTI- ARY BASIS, WITHOUT ANY EXPERTISE BROUGHT TO BEAR AND WITHOUT POSSIBILITY FOR MEANINGFUL JUDI- CIAL REVIEW	5
III. CONCLUSION	9

TABLE OF AUTHORITIES

CASES	PAGE
<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U.S. 239 (1903)	2, 4
<i>Burlington Truck Lines v. United States</i> , 371 U.S. 156 (1962)	6, 7
<i>Detroit Edison Co. v. N.L.R.B.</i> , 440 U.S. 301 (1979)	6
<i>Esquire, Inc. v. Ringer</i> , 591 F.2d 796 (D.C.Cir. 1978), cert. denied, 440 U.S. 908 (1979)	2, 3
<i>Kieselstein-Cord v. Accessories by Pearl, Inc.</i> , 632 F.2d 989 (2nd Cir. 1980)	3, 4
<i>Mazer v. Stein</i> , 347 U.S. 201 (1954)	2, 3, 4
<i>Motor Vehicle Manufacturers Association v. State Farm Mutual Automobile Insurance Co.</i> , ____ U.S. ____, 103 S.Ct. 2856 (1983)	6, 7
<i>N.L.R.B. v. Yeshiva University</i> , 444 U.S. 672 (1980)	7
STATUTES & REGULATIONS	
17 U.S.C. § 411(a)	5, 6, 8
37 C.F.R. 202.10(c) (1959)	2
OTHER	
1 M. Nimmer, <i>Nimmer On Copyright</i> , Section 2.08[B][3] (1982)	3
K. Dollahite, <i>Copyrighting Three-Dimensional Objects: Norris Industries v. International Telephone And Telegraph Corporation</i> , 35 Baylor L. Rev. ____ (1983)	5

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Petitioner, Norris Industries, Inc., respectfully submits this Reply Brief in order to respond to certain matters raised by Respondents International Telephone And Telegraph Corporation and David L. Ladd, Register of Copyrights¹, in their respective briefs in opposition to Norris' Petition For A Writ of Certiorari.

¹ Petitioner Norris Industries, Inc. is referred to hereinafter as "Norris". Respondents, International Telephone And Telegraph Corporation, and David L. Ladd, Register of Copyrights, are referred to hereinafter as "ITT" and the "Copyright Office", respectively. References to ITT's Brief In Opposition will be as follows: (ITT Br. p. —). References to the Solicitor General's Brief In Opposition on behalf of the Copyright Office will be as follows: (S.G. Br. p. —). References to the Record will be by way of the following citation: (Vol. —, p. —).

47 L.Ed. 460 (1903), '[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations . . . ' Neither the Constitution nor the Copyright Act authorizes the Copyright Office or the federal judiciary to serve as arbiters of national taste. These officials have no particular competence to assess the merits of one genre of art relative to another. And to allow them to assume such authority would be to risk stultifying the creativity and originality the copyright laws were expressly designed to encourage. *Id.* at 251-52, 23 S.Ct. 298; *accord*, *Mazer v. Stein*, *supra* at 214, 79 S.Ct. 141." 591 F.2d at 805.

The danger warned against in *Esquire* is exemplified by the Eleventh Circuit's refusal even to consider *actual evidence* submitted by Norris to the Copyright Office and in the District Court in support of the copyrightability of its Trim. The most telling example of this evil is shown by the fact that the appellate court completely ignored highly relevant and probative evidence of the *conceptual separability* of the spoke pattern of Norris' Ornamental Trim from any *supposed* utilitarian aspects of the Trim. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2nd Cir. 1980), the Second Circuit found conceptually separable sculptural elements in utilitarian belt buckles by reason of *evidence* of the decorative use of the buckles by consumers as ornamentation for parts of the body other than the waist.³ Norris submitted *equivalent evidence* of

³ Professor Melville Nimmer, a leading commentator on the copyright law, has observed: "it may be concluded that conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities. This was true of the *Kieselstein-Cord* belt buckles and of the *Mazer* sculptured dancers." 1 M. Nimmer, *Nimmer On Copyright*, Section 2.08[B][3], at 2-96.1 (1982).

conceptual separability in this case.⁴ Yet the Eleventh Circuit summarily brushed aside Norris' evidence of conceptual separability by opining as a matter of law that the belt buckles in *Kieselstein-Cord* had been registered as jewelry and that jewelry has traditionally been copyrightable, whereas Norris' Ornamental Trim do not fall within any category of fine or applied art which has traditionally been considered copyrightable. *See*: 696 F.2d at 923-924; Petition App. B, at B-11-B-13. The message of the appellate decision is clear: evidence of separability regarding the Norris Trim was ignored because in the mind of the court the Trim did not fall within an arbitrarily determined class of art called "traditional fine or applied art" — it was summarily excluded because of form only. This is *conscious discrimination* in violation of this Court's mandates in *Bleistein* and *Mazer*, *supra*.

Norris respectfully submits that the conscious discriminatory approach of the Eleventh Circuit in summarily denying copyrightability to articles which "do not fall within any of the categories of fine or applied art which have been traditionally considered copyrightable" sets a *dangerous precedent* for future cases addressing the question of the copyrightability of novel and original three-dimensional art forms. Without review and correction by this Court, the Eleventh Circuit's decision will provide a license for the Copyright Office and the courts to disregard *evidence* relevant to the *statutory* tests governing the copyrightability of such art forms, and will stand as a judicial stamp of approval for conscious and subjective discrimination

⁴ Thus, Norris' Ornamental Trim is decoratively used to adorn vehicle trunk lids where it obviously performs *no* utilitarian function. See photo in Appendix E, p. E-5 of Norris' Petition.

against any form of art which a particular administrative or judicial officer may not view as being "traditional".⁵

II.

RESPONDENTS HAVE FAILED TO JUSTIFY THE DECISION BELOW, WHICH SUMMARILY AFFIRMS AGENCY DETERMINATIONS MADE WITHOUT EVIDENTIARY BASIS, WITHOUT ANY EXPERTISE BROUGHT TO BEAR AND WITHOUT POSSIBILITY FOR MEANINGFUL JUDICIAL REVIEW.

By improperly deferring to the unsupported determinations of the Copyright Office, the lower courts in this case *foreclosed* meaningful judicial review under 17 U.S.C. §411(a) of the factual questions relating to the copyrightability of Norris' Ornamental Trim. The record reveals that the Copyright Office at no time advanced *any* technical basis and made no technical findings upon which it based its determination that Norris' Trim are useful articles, or that they lacked conceptually or physically separable aesthetic features eligible for

⁵ The significance and far-reaching implications of the lower court decision are just now becoming the subject of legal commentary. Thus, one commentator has observed in a soon to be published case note: "Copyright protection against commercial piracy is available for only a limited range of three-dimensional products. *Norris Industries v. International Telephone and Telegraph Corporation* illustrates a refusal to extend protection to existing statutory limits. It suggests registration will be denied unless the product falls within a category of useful articles 'traditionally' considered copyrightable, or unless an article's artistic features are clearly physically separable from its utilitarian aspects." (Emphasis added.) K. Dollahite, *Copyrighting Three-Dimensional Objects: Norris Industries v. International Telephone And Telegraph Corporation*, 35 Baylor L. Rev. — (1983) (quoted with permission).

The Solicitor General finally attempts to explain away the lack of technical findings, the absence of analysis, and hence the application of unquestioned deference, by unashamedly suggesting that the copyright statutes do not *require* the Copyright Office to hold an evidentiary hearing to resolve disputed questions of copyrightability (S.G. Br. p. 7). However, it is *precisely* for this reason that *meaningful, judicial review is required* in this case, as well as other future cases reviewing the Copyright Office's actions under 17 U.S.C. § 411(a). Norris is not suggesting that the agency itself was required to provide an evidentiary hearing. However, in its absence, *fundamental fairness* requires that meaningful judicial review regarding questions of material fact relating to the statutory tests of "useful article" and "separability" is required. Without review and correction by this Court, the Eleventh Circuit's decision will stand as a dangerous and far-reaching precedent allowing for agency determinations denying valuable copyright protection without evidentiary basis, without any expertise brought to bear, and without the possibility for meaningful judicial review under 17 U.S.C. § 411(a).

I.

THE SOLICITOR GENERAL ERRS IN SUGGESTING THAT NORRIS' DISCRIMINATION CLAIM WAS REJECTED IN ESQUIRE V. RINGER

The Solicitor General has incorrectly suggested (S.G. Br. p. 6 fn 7) that Norris' claim of discrimination by the appellate court² is similar to a discrimination claim previously addressed and rejected in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C.Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). However, the discrimination issue involved in this Petition is fundamentally different from that of the *Esquire* case. The Solicitor General's claim to the contrary is clearly unsupportable and disingenuous at best.

In *Esquire*, Judge Bazelon distinguished *Bleistein* and *Mazer* as dealing with *conscious bias* against particular forms of art, whereas the Copyright Office's interpretation of particular language in 37 C.F.R. 202.10(c) in the *Esquire* case resulted only in an *unintentional* and inadvertant *burden* on a particular form of art. *See*: 591 F.2d at 805. In contrast, the present Petition does not involve an *unintentional burden* placed upon a particular form of art, but rather involves *conscious* discrimination which would *disqualify* entire classes of "non-traditional" art from copyright protection. The magnitude of this evil was noted by Judge Bazelon in his opinion in *Esquire*:

"As Justice Holmes noted in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 251, 23 S.Ct. 298, 300,

² The Eleventh Circuit's decision improperly and arbitrarily discriminates between *traditional* fine and applied art as being eligible for copyright protection and the chrome plated sculpture of artificial spokes of Norris' Ornamental Trim as being ineligible, in clear violation of this Court's mandates in *Mazer v. Stein*, 347 U.S. 201 (1954), and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

copyright protection. It was only during *court proceedings* that counsel for the Copyright Office offered belated rationalizations for its actions. In accepting these after-the-fact arguments of counsel the lower courts clearly erred, since courts may not accept appellate counsel's *post-hoc* rationalizations for agency action. *Motor Vehicle Manufacturers Association v. State Farm Mutual Automobile Insurance Co.*, — U.S. —, 103 S.Ct. 2856, 2870 (1983); *Burlington Truck Lines v. United States*, 371 U.S. 156, 168 (1962).

Despite this record, which lacks supporting technical findings and analysis, the Solicitor General attempts to justify the improper use of summary procedure by noting that:

“The Copyright Office has traditionally relied upon its examination of the application and accompanying illustrations or specimens of the work to resolve such questions.” (S.G. Br. p. 7)

The simple response to this claim is that the *only* technical information in the application before the Copyright Office was the unrebutted affidavit evidence indicating that Norris' Trim are not useful articles (Vol. 4, pp. 599-625). The rationale of the Solicitor General would render an agency determination made without evidentiary support or technical findings immune from judicial review, despite technical evidentiary submissions which are contrary to the agency determination.

The only possible ground to support the summary decision below must be on the basis of blind deference. However, the rule of deference does not constitute a blank check for arbitrary action, and the role that Congress has entrusted to the courts under 17 U.S.C. § 411(a) in reviewing actions of the Copyright Office should not be that of a passive conduit. *Detroit Edison Co. v. N.L.R.B.*, 440 U.S. 301, 316 (1979). Administrative law principles require that a court should not accord deference to an agency determination which is made or arrived at on the basis of conclusory rationales, rather than

from examination of the facts of each case. *N.L.R.B. v. Yeshiva University*, 444 U.S. 672, 691 (1980). Therefore, before according deference to agency action, it must be established that the agency examined the relevant data and articulated a satisfactory explanation for its action, including a rational connection between the facts found and the choice made. *Motor Vehicle*, *supra*, 103 S.Ct. at 2866-2867; *Burlington*, *supra*, 371 U.S. at 168.

In this case, the Copyright Office's determinations amount to erroneous, unsupported, and arbitrary administrative action. What this Court recently said in *Motor Vehicle*, *supra*, has equal applicability in the present case:

"‘There are no findings and no analysis here to justify the choice made, no indication of the basis on which the [agency] exercised its expert discretion. We are not prepared to and the Administrative Procedure Act will not permit us to accept such . . . practice Expert discretion is the lifeblood of the administrative process, but ‘unless we make the requirements for administrative action strict and demanding, *expertise*, the strength of modern government, can become a monster which rules with no practical limits on its discretion.’ [Citation omitted.]’" 103 S.Ct. at 2869.

Here there was no evidence and no findings which support the agency determination. There was no meaningful technical expertise brought to bear.⁶ To *defer* to such action *compounds* agency error by denying any forum in which meaningful review of the facts regarding copyrightability may be had.

⁶ ITT offers a belated justification for deferring to the agency's determination in this case — i.e., it would be *inconvenient* for the agency to take scientific testimony regarding the technical issues relating to copyrightability of three dimensional articles (ITT Br. p. 5 fn 9). ITT's logic would lead to obviously absurd results, disastrous legal consequences, and would create the monster which this Court warned against in *Motor Vehicle*, *supra*.

III. CONCLUSION

For the reasons set forth in its Petition, as well as those set forth above, Norris respectfully submits that this Petition involves questions of fundamental importance relating to administrative law principles, as well as the proper legal tests governing copyrightability of three dimensional and other art forms. The grant of the Petition For A Writ of Certiorari is therefore most respectfully urged.

Respectfully submitted,

Of Counsel:

R. James Shaffer
NORRIS INDUSTRIES, INC.
One Golden Shore
Long Beach, Calif. 90802
(213) 435-6676

Joseph R. Papp
Charles H. Blair
John A. Sinclair
HARNES, DICKEY & PIERCE
1500 North Woodward Avenue
Birmingham, Michigan 48011
(313) 642-7000

Counsel For Petitioner Norris
Industries, Inc.

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